No. 95-_____

Supreme Court, U.S.
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IN THE

Supreme Court Of The United States

OCTOBER TERM 1995

DAN CHASE TAXIDERMY SUPPLY COMPANY, INC. and DAN CHASE,

Petitioners,

V.

SUPERIOR FORM BUILDERS, INC.,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED FOR REVIEW

1. Are lifelike polyurethane taxidermy mannequins copyrightable in their entirety?

2. Did the courts below err in holding that such mannequins are not "useful articles" as defined by the Copyright Act of 1976 (the "Copyright Act"), 17 U.S.C. § 101 *et seq.*, with limited copyrightability?

3. Did the courts below err in failing to find generic animal shapes noncopyrightable due to a merger of idea and expression?

4. Is it an abuse of discretion to combine maximum statutory damages disproportionate to *de minimis* actual damages and to completely shift liability for attorney's fees when novel and complex issues are presented?

PARTIES TO THE PROCEEDINGS BELOW

The plaintiff in the trial court was Superior Form Builders, Inc., a Virginia corporation ("SFB"). The defendants in the trial court were Dan Chase Taxidermy Supply Co., Inc., Dan Chase, and his wife, Lilly Chase. Lilly Chase was dismissed without prejudice in the trial court. Dan Chase Taxidermy Supply Co., Inc. and Dan Chase (collectively, "Chase") were appellants below. Superior Form Builders, Inc, was the appellee.

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No. 95-

IN THE
SUPREME COURT OF THE UNITED STATES
October Term, 1995

DAN CHASE TAXIDERMY SUPPLY COMPANY, INC.
and DAN CHASE,

Petitioners,

v.

SUPERIOR FORM BUILDERS, INC.,

Respondents.

PETITION FOR WRIT OF CERTIORARI

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Fourth Circuit is reported as *Superior Form Builders v. Dan Chase Taxidermy*, 74 F.3d 488 (4th Cir. 1996), and set out in the Appendix at pages 15a-36a ("App. 15a-36a").

The opinion of the United States District Court for the Eastern District of Virginia on the defendants' motion for summary judgment on the issue of copyrightability is reported as *Superior Form Builders v. Dan Chase Taxidermy Supply Co.*, 851 F.Supp. 222 (E.D.Va. 1994), *aff'd*, 74 F.3d 488 (4th Cir. 1996), and set out at App. 84a - 90a. The unreported order of the United States District Court for the Eastern District of Virginia entering judgment on the verdict of the jury after trial, is set out at App. 82a - 83a. The unreported opinion of the United States District Court for the Eastern District of Virginia denying defendants' motion for a new trial, is set out at App. 62a - 81a. The opinion of the United States District Court for the Eastern District of Virginia granting plaintiff's petition for award of attorney's fees is reported as *Superior Form Builders v. Dan Chase Taxidermy Supply Co.*, 881 F.Supp. 1021 (E.D.Va. 1994), *aff'd*, 74 F.3d 488 (4th Cir. 1996), and set out at App. 42a - 59a.

STATEMENT OF JURISDICTION

Jurisdiction is proper in this Court under 28 U.S.C. § 1254. The opinion of the United States Court of Appeals review of which is sought by this Petition was rendered January 29, 1996. Jurisdiction in the United States Court of Appeals for the Fourth Circuit was based on an appeal from the final judgment of the United States District Court for the Eastern District of Virginia. 28 U.S.C. § 1291. Jurisdiction in the trial court was based on 28 U.S.C. §§ 1331 and 1338, as this is an action arising under the Copyright Act of 1976, 17 U.S.C. § 101 *et seq.*

STATUTES

The text of 17 U.S.C. § 101 is set out in full at App. 1a-12a. In relevant part it provides:

> "Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.
>
> A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is

considered a "useful article".

17 U.S.C. § 505. Remedies for infringement: Costs and attorney's fees.

> In any civil action under this title, the court in its discretion may allow the recovery of full costs by or against any party other than the United States or an officer thereof. Except as otherwise provided by this title, the court may also award a reasonable attorney's fee to the prevailing party as part of the costs.

I. STATEMENT OF THE CASE

On September 14, 1994, SFB filed a Complaint alleging that Chase infringed copyrights on four of its taxidermy mannequins and seeking equitable relief, statutory damages in the amount of $400,000, and attorney's fees and costs.

On March 25, 1995, Chase moved for summary judgment on the grounds that SFB's taxidermy mannequins are not copyrightable and, therefore, Chase's actions could not be infringing. At issue was the legal character of SFB's polyurethane mannequins in the shape of a lying down deer, a standing and crouching raccoon and an otter, all used by taxidermists to mount animal skins.

Taxidermy mannequins are animal forms made to replicate, as accurately as possible, the muscle and skeletal structure of an animal. The mannequins merely serve as an underpinning which give a beginning shape to the finished final mount. Chase contended that SFB's mannequins are "useful articles" under the Copyright Act, and that the mannequins have no separable and independent, non-utilitarian features. It is well-understood that "useful articles" are not copyrightable, except to the extent that they have any features that can be "identified separately and exist independently" from their utilitarian function. 17 U.S.C. §

101. A "useful article" is an article that has *any* intrinsic utilitarian purpose that is not "*merely to* portray the appearance of the article or to convey information." 17 U.S.C. § 101 (emphasis added).

In this case, the taxidermy mannequins have utilitarian functions. The mannequins serve as a base for mounting animal skins; contain special receptacles for receiving artificial eyes; include "ear butts" to ensure proper placement of the animal's ears; incorporate features to facilitate the application of artificial teeth; and are made of a material that is easily altered to accommodate a particular animal skin.

On May 10, 1994, the District Court ruled that SFB's taxidermy mannequins have no utilitarian function other than portraying the appearance of the animals. *Superior Form Builders v. Dan Chase Taxidermy Supply Co., Inc.*, 851 F. Supp. 222 (E.D. Va. 1994); App. 84a - 90a. The error in the District Court's holding is made manifest by the fact that the taxidermy mannequins are not even visible when used for their intended purpose.

A jury trial on SFB's claims commenced on May 12, 1994. On May 17, 1994, the jury returned a verdict finding that Chase had willfully infringed SFB's copyrights for each of the four mannequins at issue and awarding SFB maximum statutory damages in the amount of $400,000. Judgment on the jury verdict was entered on May 20, 1994. App. 82a - 83a. Chase moved for a new trial. This motion was denied by Memorandum Opinion of August 5, 1994. App. 62a - 81a.

On September 2, 1994, Chase filed its Notice of Appeal. On September 16, 1994, the District Court awarded SFB attorney's fees and costs in the amount of $74,104.50. App. 42a - 59a. On September 23, 1994 the District Court entered an Order and Decree awarding SFB permanent injunctive relief. App. 37a - 39a. Chase filed an Amended Notice of Appeal covering all of the Orders and Judgments entered by the District Court, including all Orders entered subsequent to the initial notice, as well as the Judgment on the award of fees and costs.

On appeal, the United States Court of Appeals for the Fourth Circuit held that the taxidermy mannequins were not useful articles and affirmed the District Court's award of maximum statutory damages and attorney's fees and costs. App. 15a - 36a.

II. STATEMENT OF FACTS

In 1985, Dan Chase Taxidermy was accused of infringing the copyrights of polyurethane fish taxidermy mannequins used to mount fish skins. In 1986, the District Court for the Northern District of Alabama, Southern Division, granted summary judgment in favor of Dan Chase Taxidermy (the "Alabama lawsuit"). In an unpublished opinion, the Alabama Court concluded that the fish mannequins clearly qualified as useful articles with no separate and independent aesthetic features. The Alabama District Court held that fish mannequins were not copyrightable as a matter of law and ordered complainant's copyrights canceled. *Phillips v. Dan Chase Taxidermy Supply Co.*, No. CV85-H-690-S (N.D.Ala., Sept. 8, 1986).[1]

Chase does not dispute that it ordered the four SFB mannequins at issue in this case or that it utilized these SFB mannequins as armatures to produce Chase's taxidermy mannequins at issue. Chase covered the SFB forms with clay, resculpted the external features and modified their poses to create its models. Chase then made molds of these models to produce its own taxidermy mannequins of a lying down deer, an otter and two raccoons.

There are a limited number of ways to depict animal forms. All taxidermy mannequins must have the shape and form of the animal being depicted. The shapes and poses available for any mannequin are limited by the anatomy and range of motion of the real animal. For the taxidermy mannequin to serve its purpose, it must replicate the

[1]A copy of this unpublished opinion is being lodged with the Clerk.

anatomical features of the animal.

SFB registered all of the alleged copyrights for its mannequins at issue in this case as "Sculpture for Taxidermy" or "Sculpture for Taxidermy Manikin." SFB's mannequins are sold in its taxidermy supply catalogs.

At trial, Chase sought to prove that the only features of SFB's mannequins original to SFB were the surface features, and that the remaining features of SFB's mannequins (such as the shapes, poses, spaces, attitudes and expressions) were copied from pre-existing works and works in the public domain. It is undisputed that Chase did not copy the surface features of SFB's mannequins.

Chase also sought to prove that any infringement was not willful. Chase complained on appeal that the trial court wrongfully found copyrightability; improperly entered a judgment of infringement; misinstructed the jury on originality and willfulness; improperly excluded, impeded or commented upon Chase's defenses; and erroneously entered an excessive judgment for damages, fees and costs and unwarranted equitable relief.

III. ARGUMENT

The initial legal question is whether polyurethane taxidermy mannequins used for the mounting of animal skins that precisely replicate the anatomical features of actual animal carcasses are "useful articles" as defined in 17 U.S.C. § 101 and, if so, whether the animal mannequins possess artistic or aesthetic features that are physically or conceptually separable from their utilitarian purpose.

A "useful article" is defined in 17 U.S.C. § 101 as "an article having *an* intrinsic utilitarian function that is not *merely* to portray the appearance of the article or to convey information." *See* 17 U.S.C. § 101 (emphasis added). Although 17 U.S.C. § 102(a)(5) extends copyright protection to "pictorial, graphic, and sculptural works," the definition of "pictorial, graphic, and sculptural works," at 17 U.S.C.

§ 101, provides that the design of a useful article:

> shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

It is undisputed in this case that SFB created and marketed the four animal mannequins at issue commercially to taxidermists to be used for mounting animal skins. Further, as noted by the Court of Appeals for the Fourth Circuit, these polyurethane animal "mannequins contain[ed] special receptacles for artificial eyes, 'ear butts' for the proper placement of animal ears, and pre-molded features for the application of artificial teeth." *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co., Inc.*, 74 F.3d at 491; App. 17a.

The District Court and the Fourth Circuit misapplied § 101 of the Copyright Act defining a useful article, failing to give any effect to the word "merely." The opinion effectively reads this limitation out of the definition.

Affirming the District Court's holding, the Fourth Circuit ruled that:

> [t]hus, any utilitarian aspect of the mannequin exists 'merely to portray the appearance of' the *animal* . . . . We therefore agree with the District Court in this case because 'the usefulness of the forms is their portrayal of the appearance of animals.' The mannequin forms 'by definition are not useful articles.'

Id. at 494; App. 24a - 25a.

The District Court and the Fourth Circuit mistakenly focused on the ultimate use of the finished, mounted animal, rather than the intrinsic usefulness of taxidermy mannequins.

The taxidermy mannequins created and sold by SFB are not designed *merely* to portray the appearance of the *article* -- in this case, yellow, polyurethane mannequins replicating animal carcasses without eyes, ears or teeth. To the contrary, SFB's mannequins serve the mechanical function of supporting an animal skin, and facilitating the taxidermy mounting process. The mannequin is only a beginning point in a detailed and involved process in which the taxidermist uses glue, clay, glass and other materials to produce the finished representation. The court, by focusing on the nature of the finished product, rather than the intrinsic utilitarian function of the taxidermy mannequins, ignored the mannequins' inherent utilitarian purpose.

Because the mannequins have an intrinsic utilitarian function that is not "merely to portray the appearance of the article or to convey information," the trial court was obligated to conduct a separability analysis to determine whether the mannequins possess any copyrightable features that are physically or conceptually separable from their utilitarian purpose. *See* 17 U.S.C. § 101. In the instant case, it is undisputed that all features of the taxidermy mannequin are consumed when used in the mounting process. The yellow polyurethane animal mannequin is completely covered in the final display. Accordingly, such a separability analysis was mandated in the instant case under § 101 of the Copyright Act. Because the mannequins do not contain any features that are merely ornamental or decorative, and thus unrelated to the utilitarian purposes of the mannequins, taxidermy mannequins are not copyrightable.

The court failed to conduct a separability analysis, and thus concluded that taxidermy mannequins used for the mounting of animal skins are copyrightable. The affirmance of this error created a split among the Circuits in the interpretation and applicability of the Copyright Act. In *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985), the Second Circuit addressed the issue of whether four life-like, anatomically correct, human torso mannequins made of polystyrene used for the purposes of displaying shirts, sweaters and jackets were copyrightable. Applying § 101 of the Copyright Act, the Second Circuit

concluded that the human mannequins were "useful articles" that possessed no physically or conceptually separable artistic features, and thus were not copyrightable. The Fourth Circuit rejected the reasoning enunciated in *Barnhart*, stating:

> While we believe that *Carol Barnhart* is thus distinguishable in significant respects, to the extent that it might be construed as leaving unprotected an author's mode of expression fixed in a tangible medium for the purpose of portraying that expression, we would disagree with its holding.

Superior Forms, 74 F.3d at 494, App. 26a. The Fourth Circuit's analysis and holding in this case is contrary to the reasoning and conclusions of the Second Circuit in *Barnhart*. There is no meaningful or principled manner in which these two decisions may be distinguished or reconciled. Accordingly, issuance of a writ of certiorari is warranted to resolve these significant differences in the application of the Copyright Act.

Moreover, the merger doctrine bars copyright protection for taxidermy mannequins in the instant case. Addressing the copyrightability of a pin in the shape of a bee formed by gold encrusted with jewels, the Ninth Circuit explained that:

> when the 'idea' and its 'expression' are thus inseparable, copying the 'expression' will not be barred, since protecting the 'expression' in such circumstances would confer a monopoly of the 'idea' upon the copyright owner free from the conditions and limitations imposed by the patent law.

Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738, 742 (9th Cir. 1971).

The Ninth Circuit noted that "[a] copyright, we have seen, bars use of the particular 'expression' of an idea in a copyrighted work but does not bar use of the 'idea' itself."

Id. at 741. The Ninth Circuit noted that:

> [t]he critical distinction between 'idea' and 'expression' is difficult to draw . . . [t]he guiding consideration in drawing the line is the preservation of the balance between competition and protection reflected in the patent and copyright laws.

Id. at 742. The Ninth Circuit stressed the critical policies underlying the merger doctrine, and the risks inherent in granting copyright owners a larger private preserve than Congress intended: "What is basically at stake is the extent of the copyright owner's monopoly -- from how large an area of activity did Congress intend to allow the copyright owner to exclude others?" *Id.* Finding that the "idea" and its "expression" of the jeweled bee pens were "indistinguishable," the Ninth Circuit held that the jewel encrusted bee forms were not copyrightable. *Id.*

The applicability of the merger doctrine is perhaps even more striking in the instant case. As noted by the Fourth Circuit, SFB replicates the animal carcass in clay "with precise anatomical features." 74 F.3d at 491; App. 17a. In short, SFB is attempting to duplicate exactly the anatomical features of an actual animal carcass. The replication of the animal's anatomy is a necessity for SFB, and every other taxidermy supplier, because the taxidermy mannequins are commercially marketed to be used to mount real animal skins. Thus, regardless of the supplier, significant similarities between all taxidermy mannequins for a particular animal are inevitable. The idea of a deer mannequin is indistinguishable from the expression of a deer mannequin because all deer mannequins must strive to depict accurately the muscular and skeletal features of a deer. In effect, the Fourth Circuit has granted SFB a monopoly of the idea of its animal mannequins, free from the conditions and limitations imposed by the patent law. The fact that virtually every taxidermy supplier has access to others' mannequins, through catalogs, trade shows or other means, and the fact that mannequins necessarily have numerous similarities, permits the copyright owner to stifle competition in this

market, contrary to the policies of the Copyright Act because the mere facts of access and similarity will establish a *prima facie* case if the articles are indeed copyrightable.

Heedless of these problems, the Fourth Circuit has imposed a novel standard for copyrightability under the merger doctrine that, to appellant's knowledge, has never been employed in another court. Relying on *Herbert Rosenthal*, the Fourth Circuit stated:

> If, however, a person makes a casting rather than a sculpture of the deer, the effort introduces no originality into the product. Indeed, in such a case, the idea in the original and its expression in the casting are identical and inseparable because the mechanical process allowed for no possibility of originality, which is inherent in authorship. *In such cases, copyright protection is not available*.

74 F.3d at 493; App. 21a (emphasis added). In other words, the Fourth Circuit has imposed a new concept that the method of manufacture of a work must be known before the availability of copyright protection can be determined. Thus, if SFB had directly copied an animal carcass by making a casting, the resulting mannequin would not be copyrightable. On the other hand, if SFB precisely copies the anatomical features of an actual animal carcass using sculptural techniques, as it did in this case, the resulting mannequin is copyrightable. This standard treats two identical objects differently under the copyright laws depending on how they were made. This places an intolerable burden on other manufacturers, the Copyright Office and the courts, and is wholly contrary to the analysis employed in *Herbert Rosenthal*.

The importance of these issues of copyrightability, physical and conceptual separability and the merger doctrine are not limited to the particular facts and circumstances of the instant case. To the contrary, the copyright principles at issue in the instant case are universally applicable to every

pictorial, graphic or sculptural work. There is a paucity of case law interpreting the standards for physical and conceptual separability under the Copyright Act. To the extent such authority exists, it presents vague guidance resulting in the haphazard application of the copyright laws and inconsistent rulings under those laws. In fact, the most often cited decision of this Court on the doctrine of separability is *Mazer v. Stein*, 347 U.S. 201 (1954), issued before the statutory provisions governing separability were even enacted.

Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980), has been described as a case being "on a razor's edge of copyright law." There, the Second Circuit was called on tc determine whether two belt buckles bearing sculptural designs cast in precious metals and principally used for decoration were copyrightable. The Second Circuit concluded that the two buckles were copyrightable, relying on the fact that "[t]he primary ornamental aspect of the . . . buckles is conceptually separable from their subsidiary utilitarian function." *Id.* at 993.

The instant case presents more cutting edge separability issues than *Kieselstein-Cord*. While the buckles in *Kieselstein-Cord* contained ornamental surfaces, they were not in any respect required by the utilitarian function of the buckle and, thus, the artistic and aesthetic features could be conceived of as added to, or superimposed upon, a utilitarian article. In contrast, the designs of the taxidermy mannequins at issue in this case are inextricably intertwined with the performance of their utilitarian function. Accordingly, this case presents novel and complex issues relating to when works of applied art or industrial design incorporating aesthetic or artistic features are copyrightable.

A further substantial question also exists concerning whether SFB was entitled to an award of attorney's fees under 17 U.S.C. § 505. The court noted that if Chase had pursued the legal issues presented in this case in good faith, "an award of attorneys' fees would constitute an abuse of discretion. But the record in this case belies the suggestion

that Chase maintained his legal position in good faith" because he claimed copyright protection on mannequins of his own. 74 F.3d at 498; App. 35a. However, Chase showed that he was relying on an Alabama federal court decision holding that taxidermy mannequins used to mount fish were not copyrightable, and advice of counsel to that effect in asserting his defenses. 881 F.Supp. at 1024; App. 44a - 45a. Further, the Fourth Circuit *vindicated* Chase's positions in part, when it held that mannequins made by casting were *not* copyrightable. 74 F.3d at 493; App. 21a.

The jury awarded SFB the maximum allowable damages for intentional copyright infringement of $100,000 per infringement -- a total of $400,000. Based on virtually the same factors justifying the maximum award of statutory damages for willful infringement, the District Court also awarded SFB its attorneys' fees. 881 F.Supp. at 1024; App. 44a. Thus, this case presents the issue whether the award of attorney's fees in addition to maximum statutory damages, in light of the minimal actual damages and the magnitude of the statutory award, amounted to an unjust and excessive windfall to SFB. Chase's pursuit of various legal defenses was in accordance with existing law. The fact that Chase also claimed protection for his own works does not refute the reasonableness of his position in litigation so as to justify a windfall award of fees.

IV. CONCLUSION

Petitioner has suffered a maximum statutory award against it and a complete shifting of attorney's fees despite the fact that all prior law supports Petitioner. The opinions below create conflict between the circuits and unwarrantedly expand copyright protection beyond what Congress intended. A writ should issue to preserve coherence in this important area of intellectual property.

Respectfully submitted,

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APPENDICES

APPENDIX A

17 U.S.C. § 101

UNITED STATES CODE ANNOTATED
TITLE 17. COPYRIGHTS
CHAPTER 1--SUBJECT MATTER AND SCOPE OF COPYRIGHT

§ 101. Definitions

Except as otherwise provided in this title, as used in this title, the following terms and their variant forms mean the following:

An "anonymous work" is a work on the copies or phonorecords of which no natural person is identified as author.

An "architectural work" is the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.

"Audiovisual works" are works that consist of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works

are embodied.

The "Berne Convention" is the Convention for the Protection of Literary and Artistic Works, signed at Berne, Switzerland, on September 9, 1886, and all acts, protocols, and revisions thereto.

A work is a "Berne Convention work" if--

(1) in the case of an unpublished work, one or more of the authors is a national of a nation adhering to the Berne Convention, or in the case of a published work, one or more of the authors is a national of a nation adhering to the Berne Convention on the date of first publication;

(2) the work was first published in a nation adhering to the Berne Convention, or was simultaneously first published in a nation adhering to the Berne Convention and in a foreign nation that does not adhere to the Berne Convention;

(3) in the case of an audiovisual work--

(A) if one or more of the authors is a legal entity, that author has its headquarters in a nation adhering to the Berne Convention; or

(B) if one or more of the authors is an individual, that author is domiciled, or has his or her habitual residence in, a nation adhering to the Berne Convention;

(4) in the case of a pictorial, graphic, or sculptural work that is incorporated in a building or other structure,

the building or structure is located in a nation adhering to the Berne Convention; or

(5) in the case of an architectural work embodied in a building, such building is erected in a country adhering to the Berne Convention.

For purposes of paragraph (1), an author who is domiciled in or has his or her habitual residence in, a nation adhering to the Berne Convention is considered to be a national of that nation. For purposes of paragraph (2), a work is considered to have been simultaneously published in two or more nations if its dates of publication are within 30 days of one another.

The "best edition" of a work is the edition, published in the United States at any time before the date of deposit, that the Library of Congress determines to be most suitable for its purposes.

A person's "children" are that person's immediate offspring, whether legitimate or not, and any children legally adopted by that person.

A "collective work" is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.

A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term "compilation" includes collective works.

"Copies" are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "copies" includes the material object, other than a phonorecord, in which the work is first fixed.

"Copyright owner", with respect to any one of the exclusive rights comprised in a copyright, refers to the owner of that particular right.

The "country of origin" of a Berne Convention work, for purposes of section 411, is the United States if--

(1) in the case of a published work, the work is first published--

(A) in the United States;

(B) simultaneously in the United States and another nation or nations adhering to the Berne Convention, whose law grants a term of copyright protection that is the same as or longer than the term provided in the United States;

(C) simultaneously in the United States and a foreign nation that does not adhere to the Berne Convention; or

(D) in a foreign nation that does not adhere to the Berne Convention, and all of the authors of the work are nationals, domiciliaries, or habitual residents of, or in the case of an audiovisual work legal entities with headquarters in, the United States;

(2) in the case of an unpublished work, all the authors of the work are nationals, domiciliaries, or habitual residents of the United States, or, in the case of an unpublished audiovisual work, all the authors are legal entities with headquarters in the United States; or

(3) in the case of a pictorial, graphic, or sculptural work incorporated in a building or structure, the building or structure is located in the United States.

For the purposes of section 411, the "country of origin" of any other Berne Convention work is not the United States.

A work is "created" when it is fixed in a copy or phonorecord for the first time; where a work is prepared over a period of time, the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work.

A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work".

A "device", "machine", or "process" is one now known or later developed.

A "digital transmission" is a transmission in whole or in

part in a digital or other non-analog format.

To "display" a work means to show a copy of it, either directly or by means of a film, slide, television image, or any other device or process or, in the case of a motion picture or other audiovisual work, to show individual images nonsequentially.

A work is "fixed" in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is "fixed" for purposes of this title if a fixation of the work is being made simultaneously with its transmission.

The terms "including" and "such as" are illustrative and not limitative.

A "joint work" is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.

"Literary works" are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.

"Motion pictures" are audiovisual works consisting of a series of related images which, when shown in succession,

impart an impression of motion, together with accompanying sounds, if any.

To "perform" a work means to recite, render, play, dance, or act it, either directly or by means of any device or process or, in the case of a motion picture or other audiovisual work, to show its images in any sequence or to make the sounds accompanying it audible.

"Phonorecords" are material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "phonorecords" includes the material object in which the sounds are first fixed.

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

A "pseudonymous work" is a work on the copies or phonorecords of which the author is identified under a

fictitious name.

"Publication" is the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication.

"Registration", for purposes of sections 205(c)(2), 405, 406, 410(d), 411, 412, and 506(e), means a registration of a claim in the original or the renewed and extended term of copyright.

To perform or display a work "publicly" means--

(I) to perform or display it at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered; or

(2) to transmit or otherwise communicate a performance or display of the work to a place specified by clause (1) or to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive it in the same place or in separate places and at the same time or at different times.

"Sound recordings" are works that result from the fixation of a series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material

objects, such as disks, tapes, or other phonorecords, in which they are embodied.

"State" includes the District of Columbia and the Commonwealth of Puerto Rico, and any territories to which this title is made applicable by an Act of Congress.

A "transfer of copyright ownership" is an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright, whether or not it is limited in time or place of effect, but not including a nonexclusive license.

A "transmission program" is a body of material that, as an aggregate, has been produced for the sole purpose of transmission to the public in sequence and as a unit.

To "transmit" a performance or display is to communicate it by any device or process whereby images or sounds are received beyond the place from which they are sent.

The "United States", when used in a geographical sense, comprises the several States, the District of Columbia and the Commonwealth of Puerto Rico, and the organized territories under the jurisdiction of the United States Government.

A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article".

The author's "widow" or "widower" is the author's surviving spouse under the law of the author's domicile at the time of his or her death, whether or not the spouse has later remarried.

A "work of visual art" is--

(1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or

(2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

A work of visual art does not include--

(A)(i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication;

(ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container;

(iii) any portion or part of any item described in clause (i) or (ii);

(B) any work made for hire; or

(C) any work not subject to copyright protection under this title.

A "work of the United States Government" is a work prepared by an officer or employee of the United States Government as part of that person's official duties.

A "work made for hire" is--

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire. For the purpose of the foregoing sentence, a "supplementary work" is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwards, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an "instructional text" is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.

A "computer program" is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.

APPENDIX B

FILED: March 27, 1996

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 94-2139
(CA-93-940-N)

SUPERIOR FORM BUILDERS,

Plaintiff - Appellee,

versus

DAN CHASE TAXIDERMY SUPPLY COMPANY, INCORPORATED; DAN CHASE,

Defendants - Appellants,

and

LILLY CHASE,

Defendant.

ORDER

Appellee has filed a motion for attorney's fees. Appellants have filed a response.

The Court grants the petition for attorney's fees and awards fees in the amount of $10,070.

Entered at the direction of Judge Niemeyer with the concurrence of Judge Michael and Judge Motz.

For the Court

/s/ Bert M. Montague

Clerk

APPENDIX C

PUBLISHED

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

SUPERIOR FORM BUILDERS, INC.,

Plaintiff-Appellee,

v. No. 94-2139

DAN CHASE TAXIDERMY SUPPLY COMPANY, INCORPORATED; DAN CHASE,

Defendants-Appellants,

and

LILLY CHASE,

Defendant.

Appeal from the United States District Court
for the Eastern District of Virginia, at Norfolk.
Rebecca B. Smith, District Judge.
(CA-93-940-N)

Argued: July 12, 1995

Decided: January 29, 1996

Before NIEMEYER, MICHAEL, and MOTZ, Circuit Judges.

Affirmed by published opinion. Judge Niemeyer wrote the opinion, in which Judge Michael and Judge Motz joined.

COUNSEL

ARGUED: Earle Duncan Getchell, Jr., MCGUIRE, WOODS, BATTLE & BOOTHE, Richmond, Virginia, for Appellants. Gregory Albert Giordano, SHUTTLEWORTH, RULOFF, GIORDANO & KAHLE, P.C., Virginia Beach, Virginia, for Appellee. **ON BRIEF:** Amy T. Holt, Frank G. LaPrade, III, MCGUIRE, WOODS, BATTLE & BOOTHE, Richmond, Virginia, for Appellants. Lawrence H. Woodward, Jr., SHUTTLEWORTH, RULOFF, GIORDANO & KAHLE, P.C., Virginia Beach, Virginia; F. Prince Butler, GRIFFIN, BUTLER, WHISENHUNT & KURTOSSY, Arlington, Virginia, for Appellee.

OPINION

NIEMEYER, Circuit Judge:

The principal issue presented in this appeal is whether animal mannequins used by taxidermists to mount animal

skins are copyrightable. The controversy centers around whether these mannequins are "useful articles" or "sculptural works" within the meaning of the Copyright Act, and if useful, whether their sculptural features are conceptually separable and thus copyrightable. We also must decide evidentiary and damage issues arising from the trial in the district court.

Because these animal mannequins were designed to portray the appearance of animals through artistic features introduced by the author in their creation, we hold that they are not "useful articles" as defined in the Copyright Act and that therefore copyright protection is available for them. Because we also reject the assignments of error attributed to the evidentiary and damage rulings, we affirm.

I

Superior Form Builders, Inc. ("Superior Form"), through its owner and president, Tommy Knight, creates and markets animal mannequins for mounting animal skins. Employing traditional sculpturing techniques, Knight creates the mannequins, using casts of actual animal carcasses as models. He begins by applying clay to an armature made of wood and actual animal bones and shaping the desired animal in a particular pose and with precise anatomical features. From the clay sculpture, he makes a fiberglass mold and uses it to produce polyurethane forms, i.e. the animal mannequins. The mannequins contain special receptacles for artificial eyes, "ear butts" for the proper placement of animal ears, and pre-molded features for the application of artificial teeth.

Knight considers his mannequins to be a form of

artistic expression and has entered several of his unadorned mannequins in art contests. Some have won awards.

Knight registered each of his mannequins with the United States Copyright Office and then assigned the copyrights to his company, Superior Form. Superior Form issued its first catalog with Knight's mannequins in December 1991.

In January 1992, Dan Chase Taxidermy Supply Co., Inc. ("Chase Taxidermy"), a Superior Form competitor, ordered four mannequins from Superior Form's catalog: an otter, two raccoons in different poses, and a deer. Dan Chase, the president and chief executive officer of Chase Taxidermy, used the name of a fictional company in placing the order because he feared that Superior Form would not send the forms otherwise. Chase Taxidermy also used pseudonyms in the past to obtain animal mannequins from other companies.

Chase Taxidermy used the four Superior Form mannequins to develop its own forms, making few or no modifications. After registering the mannequins as its own with the Copyright Office, Chase Taxidermy offered these mannequins for sale in its 1992-93 catalog and in each edition thereafter, with its own copyright notice attached.

Chase Taxidermy advertises that it is the largest taxidermy supply company in the world and offers over 3,000 forms for sale through its catalog. Although Chase Taxidermy developed many of its forms from competitors' mannequins, it represented in its initial catalogs that "each mannequin in this catalog is legally copyrighted according to

the law of the United States of America and any infringement will be vigorously prosecuted." In later catalogs, it warned, "Beware of look-a-likes," and explained:

> Practically everyone recognizes the fact that we are being copied by the desperate "copy cats" working overtime in an attempt to deceive the public and violate the rights of others.

In September 1993, Superior Form filed suit against Chase Taxidermy and Dan Chase alleging that the defendants (hereinafter "Chase") had infringed Superior Form's copyrights on the four animal mannequins that Chase had purchased from Superior Form. Lilly Chase, Dan Chase's wife, was also named a defendant, but she was subsequently dismissed because the court lacked personal jurisdiction over her. Superior Form's complaint sought equitable relief, statutory damages of $400,000, and attorneys fees and costs. Chase moved for summary judgment on the ground that Superior Form's mannequins are not copyrightable because they are "useful articles" that do not have separable and independent sculptural features. The district court denied the motion, ruling as a matter of law that the taxidermy mannequins are copyrightable since they have no utilitarian function other than portraying the appearance of an animal and that such a portrayal is "unquestionably a permanent artistic object."

The case proceeded to trial before a jury on the issues of whether Chase infringed Superior Form's copyrights and whether the infringement was willful. The jury returned a special verdict, finding in favor of Superior Form on all issues and awarding Superior Form the maximum statutory

damages of $100,000 on each of the four works that Chase had copied. The district court denied Chase's motion for a new trial and, following a hearing, awarded Superior Form $74,104.50 in attorneys fees and costs. The court found that Chase had been involved in similar infringement suits for years and that only "substantial awards of damages as well as attorney's fees will deter Mr. Chase from continuing this willful and outrageous conduct." From the judgment entered, Chase appeals.

II

We turn first to the question of whether the Copyright Act affords Superior Form copyright protection for its animal mannequins.

The Copyright Act provides copyright protection for "original works of authorship fixed in any tangible medium of expression," including "sculptural works." 17 U.S.C. § 102(a)(5). Copyright protection, which gives authors the exclusive right to use, publish, and sell their work, is intended "to promote the Progress of Science and useful Arts." *See* U.S. Const. art. I, § 8, cl. 8.

The copyright is the author's right to prohibit the copying of the author's intellectual invention, i.e. the originality of an author's expression. Since individual expressions of ideas inevitably vary, the originality inherent in each author's expression is the essence of the proprietary interest protected. *See Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991). Originality requires "independent creation plus a modicum of creativity." *Id.* Copyright protection is available even if the quantum of originality is minimal. *Id.* at 348.

But the public has a corollary interest against any grant of an undeserving monopoly. Thus, while the Copyright Act affords protection for originality inherent in authorship, it retains in the public domain the right to discover facts and exchange ideas freely. Thus, copyright protection does not extend to ideas or facts, *see* 17 U.S.C. § 102(b), even if such facts were discovered as the product of long and hard work. A copyright "rewards originality, not effort." *Feist*, 499 U.S. at 364. It follows, therefore, that while authors are free to adopt ideas, narrate facts, and copy an original, they are not free "to copy the copy." *Bleistein v. Donaldson Lith. Co.*, 188 U.S. 239, 249 (1903).

Accordingly, an animal sculpture, even if realistic, is copyrightable as long as the work represents the author's creative effort. *See, e.g., Kamar Int'l, Inc. v. Russ Berrie and Co.*, 657 F.2d 1059 (9th Cir. 1981). Several sculptors may copy a deer, even the same deer, in creating a sculpture, and each may obtain copyright protection for his or her own expression of the original. *See Rachel v. Banana Republic, Inc.*, 831 F.2d 1503 (9th Cir. 1987). Such individual creative efforts inevitably possess some degree of originality. But when an author copies another author's work, he appropriates that author's propriety interest in the work, the author's individual expression.

If, however, a person makes a casting rather than a sculpture of the deer, the effort introduces no originality into the product. Indeed, in such a case, the idea in the original and its expression in the casting are identical and inseparable because the mechanical process allowed for no possibility of originality, which is inherent in authorship. In such cases, copyright protection is not available. *See Herbert Rosenthal*

Jewelry Corp. v. Kalpakian, 446 F.2d 738, 742 (9th Cir. 1971) (holding that where idea and expression are indistinguishable, copying the expression would not be barred by copyright registration).

In this case, no one has seriously disputed the fact that Knight individually created sculptural works and thereby introduced originality into them. Even though his works realistically depict animals, they are not mere "castings" of animal carcasses. To the contrary, Knight constructs armatures to which he applies clay, forming what becomes clay sculptures of animals in particular poses. Chase's counsel conceded at trial that Knight formed his sculptures "from scratch" and that therefore there was some originality in each of his works. These clay sculptures were Knight's tangible expressions of animals and thus contained originality, which is required as a condition for obtaining copyright protection. *See Feist*, 499 U.S. at 346.

While Chase offers no serious challenge to the originality of Knight's work, he does contend that by using the sculpted forms to mount animal skins, Superior Form's mannequins serve a utilitarian purpose and therefore are not copyrightable. As Chase argues, the mannequin is "one of the tools of a taxidermist as utilitarian as the glue, clay, glass and other materials used in mounting an animal." To support his contention, Chase relies on a Second Circuit case holding that human mannequins used to display clothes for commercial sale are not copyrightable. *See Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985).

Superior Form responds that its mannequins are in fact "sculptural works," not "useful articles," within the meaning of the Copyright Act. Alternatively, it argues that

any utilitarian aspect of the mannequins is conceptually separable from their sculptural features. Superior Form analogizes its mannequins to the mannequins the Ninth Circuit has recognized as copyrightable. *See Rachel*, 831 F.2d at 1507 (recognizing that animal mannequins painted, fitted with artificial eyes, and covered with flocking are copyrightable); *Kamar Int'l*, 657 F.2d at 1061, (holding that stuffed toy animals are copyrightable).

The Copyright Act excludes from copyright protection any "useful article," defining such an article as "having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101. A "sculptural work," however, does not lose its copyrightability even if it has utilitarian aspects so long as the "sculptural features . . . can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101 (defining "pictorial, graphic, and sculptural work"). When the sculptural features and utilitarian aspects are not separable, the work is not copyrightable, although it may be protectable on a more limited basis with a design patent. Thus, the industrial design of a unique, aesthetically pleasing chair cannot be separated from the chair's utilitarian function and, therefore, is not subject to copyright protection. But the design of a statue portraying a dancer, created merely for its expressive form, continues to be copyrightable even when it has been included as the base of a lamp which is utilitarian. *See Mazer v. Stein*, 347 U.S. 201, 205 (1954). The objective in designing a chair is to create a utilitarian object, albeit an aesthetically pleasing one; the objective in creating a statue of a dancer is to express the idea of a dancer. As the Act makes the distinction, a useful article has as its function something more than portraying its own appearance.

See 17 U.S.C. § 101 (defining "useful article").

In this case, Chase argues that Superior Form's animal mannequins have the utilitarian function of acting as mounts for animal skins for display. But this argument overlooks that which distinguishes mannequins from ordinary plastic foam pellet animal stuffing: A mannequin provides the creative form and expression of the ultimate animal display, whereas pellets do not. Even though covered with a skin, the mannequin is not invisible but conspicuous in the final display. The angle of the animal's head, the juxtaposition of its body parts, and the shape of the body parts in the final display is little more than the portrayal of the underlying mannequin. Indeed, the mannequin can even portray the intensity of flexed body parts, or it can reveal the grace of relaxed ones. None of these expressive aspects of a mannequin is lost by covering the mannequin with a skin. Thus, any utilitarian aspect of the mannequin exists "merely to portray the appearance" of the animal. *See* 17 U.S.C. § 101.

The very same considerations that distinguish useful articles from sculptural works thus qualify mannequins designed to display trophy animals for copyright protection; the author's artistic portrayal of the animal form survives the final assemblage. It is the portrayal of the animal's body expression given by the mannequin that is thus protectable under the Copyright Act. *See Rachel*, 831 F.2d at 1507; *cf. Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663 (3rd Cir. 1990) (finding nose mask for humans copyrightable because its sole function is to portray appearance of article); *Kamar Int'l*, 657 F.2d at 1061. We therefore agree with the district court in this case because "the usefulness of the forms is their portrayal of the

appearance of animals." The mannequin forms "by definition are not useful articles."

To the extent that an argument can be made that the mannequins in this case perform a utilitarian function——rather than portraying themselves——by supporting the mounted skins, we believe the function to be conceptually separable from the works' sculptural features. *See Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987) ("Where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists"); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (finding sculptural element of belt buckle conceptually separable from utilitarian function).

We are not persuaded that the decision in *Carol Barnhart* compels a different result. In that case, the Second Circuit concluded that human mannequins used to display clothes for commercial sale were aesthetically pleasing articles of industrial design and were not designed for portraying themselves:

> [T]he aesthetic and artistic features of the Barnhart forms are inseparable from the forms' use as utilitarian articles .... While [sculptural techniques in creating the forms] may indicate that the forms are "aesthetically satisfying and valuable," it is insufficient to show that the forms possess aesthetic or artistic features that are physically or conceptually

> separable from the forms' use as utilitarian objects to display clothes.

773 F.2d at 418. The court did not find that the author fixed a mode of expression in a tangible form *for the purpose of displaying or portraying the article*.

The human mannequins considered in *Carol Barnhart* are quite unlike Standard Form's animal mannequins, which are intended to give body expression to the final displays and to constitute a permanent portrayal of the animal. While we believe that *Carol Barnhart* is thus distinguishable in significant respects, to the extent that it might be construed as leaving unprotected an author's mode of expression fixed in a tangible medium for the purpose of portraying that expression, we would disagree with its holding. The court in *Mazer* articulates the relevant distinction:

> The dichotomy of protection...is...art for the copyright and the invention of original and ornamental design for design patents. We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration.

347 U.S. at 218.

Accordingly, we hold that the originality of expression fixed in Superior Form's plastic mannequins, used for mounting animal skins for permanent display, is protectable as a sculptural work under the Copyright Act.

III

Chase also contends that a new trial is required because the district court erred in its evidentiary rulings and jury instructions. We review the district court's evidentiary rulings for abuse of discretion and its jury instructions *de novo*.

Chase first argues that the district court abused its discretion by refusing to allow testimony that Knight's work was not original because he had copied significant portions of his mannequins from preexisting works. But Chase's counsel admitted at trial that Knight had constructed his mannequins "from scratch," using as models plaster masks of actual animals. By observing nature in the form of the masks, Knight created clay models with his own hands, and from these models he made the mannequins. Even though Knight had sculpted the animal forms himself, the district court permitted Chase to introduce evidence that Superior Form's mannequins were not entirely original and allowed Chase to argue that he had copied only unoriginal aspects of Superior Form's mannequins. In these circumstances, we conclude that the district court did not abuse its discretion in refusing to permit Chase to present evidence that Superior Form's works were copied in their entirety from preexisting work.

For similar factual reasons, we also reject Chase's challenge to the district court's instructions on originality. The court correctly stated that because it had found as a matter of law that Superior Form's mannequins were Knight's original works, subject to copyright protection, the jury "need not concern themselves with that matter." And the court further explained that "there is no liability unless it

is the original aspects of the plaintiff's work that are copied or taken." The court thus accommodated Chase's claim that he copied only unoriginal aspects of Superior Form's mannequins. We find no reversible error in the court's giving these instructions.

Chase also contends that the district court improperly hampered his defense to Standard Form's claim of intentional infringement by excluding evidence that Chase had relied on the advice of counsel in determining that taxidermy mannequins are not copyrightable. While such a contention is remarkably inconsistent with Chase's own efforts to obtain copyright protection for its mannequins and its public statements that its own mannequins were copyrighted, evidence of reliance on the advice of counsel is generally probative of a party's lack of willfulness in infringing a copyright. *See RCA/Ariola, Int'l, Inc. v. Thomas & Grayston Co.*, 845 F.2d 773, 779 (8th Cir. 1988). In this case, however, Chase was not denied the opportunity to present such evidence. At most, the court deferred one effort by Chase to explain what counsel told him. On that occasion, the court directed Chase's counsel to proceed to another area of inquiry, but stated, "[I]f you want to reask it later when we get the jury out for lunch break, you can tell me why [the witness] can say that he never [honored Superior Form's copyrights] because he was of the opinion that it was okay to copy [the mannequins]." Chase never followed up on the court's offer, perhaps for strategic reasons. We find no error in the district court's handling of this matter.

In a similar vein, Chase argues that the district court improperly excluded evidence of Chase's reliance on a finding by an Alabama district court that fish mannequins are

not copyrightable. The record reveals, however, that the district court only prohibited Chase from interpreting the Alabama court's ruling. The court permitted Chase to testify that after the Alabama case, it was his "understanding that [he] could continue to work off of others' forms." The court also permitted Chase to introduce as an exhibit a copy of the Alabama court's decision. With respect to this matter, we agree with the district court's observation in its memorandum opinion denying Chase's motion for a new trial: "Mr. Chase was given substantial opportunity to explain what the [Alabama] case led him to believe; he simply was not allowed to tell the jury what the case meant objectively as a matter of law."

As his final ground for a new trial, Chase contends that the district court's instruction on willful infringement was misleading and prejudicial. The court instructed the jury:

> In general, evidence that notice has been accorded to the defendants before the specific facts found to have constituted infringement occurred is perhaps the most persuasive evidence of willfulness. It's not the only way that willfulness can be established.

Chase acknowledges that the instruction is an accurate statement of the law, as quoted from *Video View, Inc. v. Studio 21 Ltd.*, 925 F.2d 1010, 1021(7th Cir.), *cert. denied*, 502 U.S. 861 (1991). But he argues nevertheless that "the instruction left the jury with the impression that all [Superior Form] had to prove on the issue of willful infringement was that Chase disregarded [Superior Form] copyright notices."

Because Chase offered no modification, alternative, or additional instruction at trial to ameliorate his concern, however, we conclude that the district court did not err in giving the instruction.

IV

Finally, Chase contends that the award of statutory damages was improper and excessive and that the award of attorneys fees was unjustified. The jury awarded Superior Form $400,000 in statutory damages, the maximum allowable, and the district court awarded Superior Form $74,104.50 in attorneys fees and costs. Chase does not challenge the reasonableness of the amount of the attorneys fees.

Chase argues that the statutory damages must bear some reasonable relationship to the amount of actual damages and "should not amount to a windfall" or punishment. He points out that his gross revenue from the sale of the contested mannequins was roughly $10,200 and that Superior Form was not able to identify any damages caused by his misappropriation. Chase further notes that the $400,000 awarded by the jury is more than double the combined net income of Dan Chase Taxidermy for fiscal years 1991 and 1992, which totaled roughly $170,000.

The Copyright Act provides that "an infringer of copyright is liable for either...actual damages...or... statutory damages as provided by subsection (c)." 17 U.S.C. § 504(a). And subsection (c) provides:

> In a case where the copyright owner sustains the burden of proving, and the court finds, that infringement was committed willfully, the court in its discretion may increase the award of statutory damages to a sum of not more that $100,000.

15 U.S.C. § 504(c)(2). Thus, if the jury was presented with evidence justifying a finding of willful infringement, it is given broad discretion to award up to $100,000 for each work copied. Our review of such an award is even more deferential than abuse of discretion. *See Douglas v. Cunningham*, 294 U.S. 207, 210 (1935); *Broadcast Music, Inc. v. Star Amusement, Inc.*, 44 F.3d 485, 487 (7th Cir. 1995).

In this case the jury was properly instructed on its discretionary authority under the Copyright Act. The court told the jury that if it found willfulness, it should determine the appropriate damages by focusing not only on the actual damages suffered by the plaintiffs, but also on:

> any evidence that the defendants have a history of copyright infringement; any evidence that the defendants are apparently impervious to either deterrence or rehabilitation; the extent of the defendant's knowledge of the copyright laws; any misleading or false statements made by the defendants;...and any factor which the jury believes evidences the defendants knew, had reason to know, or recklessly disregarded the fact that its conduct constituted copyright

infringement.

See, e.g., F. W. Woolworth Co. v. Contemporary Arts, Inc., 344 U.S. 228, 234 (1952) (holding that recovery is not limited to gross profit from infringement; court may consider all facts); *Chi-Boy Music v. Charlie Club, Inc.*, 930 F.2d 1224, 1229 (7th Cir. 1991) (holding that court may consider several factors in awarding damages under copyright Act, including deterrence and circumstances of infringement). Moreover, the jury was presented with evidence substantially implicating each of those factors.

The record supports the conclusion that Dan Chase Taxidermy became the largest taxidermy supplier in the country by consistently and deliberately copying competitors' forms in disregard of the copyright laws. Dan Chase acknowledged, that of the 3,000 molds in his catalog, 150 to 200 were made from competitors' molds. He explained:

> This generally is done in the industry in order to seek out mannequins from different companies. I'm sure our company because of the fact we've worked so hard to produce so many is probably ordered from more than anybody and worked off of them more than anybody.

But in 1989, Chase was sued by Sportsmen On Film, Inc. for copyright infringement. The complaint there alleged that Chase purchased copyrighted tapes from Sportsmen On Film, erased that company's name, substituted the name of Chase Taxidermy, and falsely packaged and labeled the tape with his own copyright notice. At the trial in this case, Dan

Chase testified that he had "admitted everything" in the previous case and confessed, "I made a sad error. We paid for it, and that was the end of it."

In 1987, Chase was sued by Jonas Brothers, a taxidermy supply company, for copyright infringement. While Chase settled that case, he was again charged by Jonas Brothers with copyright infringement several years later. Chase has also been accused by at least three other people in the industry of illegally copying their taxidermy mannequins. And Chase is currently being sued in the Northern District of New York by 11 plaintiffs who allege that Chase illegally infringed copyrights on taxidermy mannequins.

Moreover, evidence was presented at trial that Chase has acted in a manner that is inconsistent with his position maintained at trial that taxidermy mannequins are not copyrightable. In earlier versions of his catalogs, Chase represented that "each mannequin in this catalog is legally copyrighted according to the law of the United States of America and any infringement will be vigorously prosecuted." When a judge determined in another litigation that one of Chase's fish forms was not copyrightable, Chase replaced the broad copyright statement from his catalog with the warning, "Beware of look-a-likes," and the explanation that "desperate copycats" are "working overtime in an attempt to deceive the public and violate the rights of others." Even then, however, Chase continued to affix copyright notices to his taxidermy mannequins. When asked why, Chase testified at trial that he did it to "bluff" others so that they would not copy his mannequins.

After Chase acknowledged that he was a member of the National Taxidermy Association, he was asked whether

he follows the Association's ethical rule: "I will not cast or reproduce any form or part thereof except my own, sculpted by me or my employee unless I have the specific permission to do so from the originator of the form." Chase testified that he did not consider the rule meaningful and described the Code of Ethics as "whitewash" that was never intended to be followed. The Code was, according to Chase, "passed for show."

Finally, the most telling evidence of willful infringement in this case is Chase's underhanded purchase of the four Superior Form mannequins using pseudonyms, his removal of Superior Form's copyright notice from those forms, and his attachment of his own copyright notice. Such conduct is inconsistent with any claim of innocence or justification. The jury had ample evidence from which to conclude that illegal copying of competitors mannequins was a course of business for Dan Chase Taxidermy and that the maximum statutory damages was suitable.

With respect to attorneys fees, Chase argues that attorneys fees are not to be awarded as a matter of course under 17 U.S.C. § 505. He notes, moreover, that because of the enormous statutory damages, Superior Form has been "more than adequately compensated for any injury or expense incurred." Chase concludes, "the magnitude of [Superior Form's] award is already grossly excessive without further punishing Chase by awarding [attorneys] fees and costs." We conclude, however, that the district court did not abuse its discretion in the circumstances of this case.

A court may award costs and "may also award a reasonable attorney's fee to the prevailing party as part of the

costs." 17 U.S.C. § 505. Chase is correct in noting that such awards are not to be made as a matter of course but, rather, as a matter of the court's discretion. *See Fogerty v. Fantasy, Inc.*, 114 S. Ct. 1023, 1033 (1994). In exercising such discretion, we have instructed district courts to consider: (1) the motivation of the parties; (2) the objective reasonableness of the legal and factual positions advanced; (3) the need in particular circumstances to advance considerations of compensation and deterrence; and (4) any other relevant factor presented. *See Rosciszewski v. Arete Assoc., Inc.*, 1 F.3d 225, 234 (4th Cir. 1993).

Chase maintains that he had a reasonable basis to test the legal question of whether animal mannequins are copyrightable and thus he should not be assessed legal fees for doing so. He points to the district court's assessment that the case "presented legal questions that were novel and complex." We agree that if Chase had pursued these legal issues in good faith, an award of attorneys fees would constitute an abuse of discretion. But the record in this case belies the suggestion that Chase maintained his legal position in good faith.

The record shows that Chase adopted a business practice of copying animal mannequins created by competitors, justifying the practice with the claim that animal mannequins are not copyrightable. As a result of this practice he has been sued repeatedly for copyright infringement. At the same time that he was making the contention that animal mannequins are not copyrightable, however, he was applying for copyrights for his own mannequins, affixing copyright notices to them, and warning others that his mannequins are "legally copyrighted" and "any infringement will be vigorously prosecuted." When one

of his fish mannequins was found by a court to be not copyrightable —— a decision that he now argues vindicates his contention that animal mannequins are not copyrightable —— he nevertheless continued to warn the public, "Beware of look-a-likes," and "[D]esperate 'copy cats' [are] working overtime in an attempt to deceive the public and *violate the rights of others*." (Emphasis added). Moreover, he continued to attach copyright notices to his mannequins to "bluff" others into believing his forms were copyrighted. He admits that he is a member of a trade association that has adopted an ethical code that prohibits copying, but characterizes the code as "whitewash," which was "passed for show."

The district court recognized that it was not required to award attorneys fees to the prevailing party and did so only after carefully considering each of the relevant factors. In this case, it found Chase's conduct "outrageous," and we conclude that the court's finding is amply supported. Under such circumstances, we do not find the district court's award in this case to constitute an abuse of discretion.

For the foregoing reasons, the judgment of the district court is

AFFIRMED.

APPENDIX D

IN UNITED STATES DISTRICT COURT
For the Eastern District of Virginia
Norfolk Division

SUPERIOR FORM BUILDERS,INC. Plaintiff,	)	
v.	)	Case Number: 2:93cv940
DAN CHASE TAXIDERMY SUPPLY CO, INC., CO., INC., et al. Defendants.	)	

ORDER AND DECREE

This cause came on the motion of the Plaintiff for the entry of an order granting it an injunction and for other relief including impoundment and destruction of articles found to be infringing on the Plaintiff's copyrights and for good cause shown,

IT IS ADJUDGED ORDERED AND DECREED as follows:

The defendants are hereby ordered to refrain from and are enjoined from selling or distributing any molds or

copies of the forms found by the jury to infringe on plaintiff's copyrights. The defendants are further ordered to refrain from and are enjoined from displaying in any future catalogue, magazine, pamphlet or literature any of the molds or forms or copies of the forms found by the jury to infringe on plaintiff's copyrights.

All forms, molds, copies of the forms, plaster casts, or photographs of the forms, within defendants' control, found by the jury to infringe the plaintiff's copyrighted works, are to be destroyed within thirty (30) days of the entry of this order or, if appealed, within thirty (30) days after the appeal mandate issues, provided that the jury's verdict is upheld, or within thirty (30) days after the appeal is withdrawn. Defendants shall provide plaintiff and the court with an inventory of all such forms, molds, casts, etc. within their control, and shall certify to the court that they have destroyed said forms, casts, molds, etc. Defendants shall provide the inventory and certification within thirty (30) days of the entry of this order or, if appealed, within thirty (30) days of the date that the appeal mandate issues, provided that the jury's verdict is upheld, or within thirty (30) days after the appeal is withdrawn.

Entered this /s/ 23rd day of September, 1994.

/s/ Rebecca Beach Smith
The Honorable Rebecca B. Smith

I ASK FOR THIS:

/s/ Gregory A. Giordano p.q.

SEEN AND OBJECTED TO: /s/ For reasons previously stated on record. RBS

/s/ Amy T. Holt p.q.

APPENDIX E

UNITED STATES DISTRICT COURT
Eastern District of Virginia
Norfolk Division

Superior Form Builders,

Plaintiff,

v. Case Number: 2:93cv940

Dan Chase Taxidermy Supply Co., Inc., Dan Chase,

Defendants.

JUDGMENT IN A CIVIL CASE

Jury Verdict. This action came before the Court for a trial by jury. The issues have been tried and the jury has rendered its verdict.

X Decision by Court. This action came to decision before the Court. The issues have been decided and a decision has been rendered.

IT IS ORDERED AND ADJUDGED that plaintiff's motion for attorney's fees and costs is GRANTED in the amount of $74,104.50.

September 16, 1994 DORIS R. CASEY, CLERK
Date

By: /s/ Rhonda D. Lambert
Rhonda D. Lambert

APPENDIX F

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
Norfolk Division

SUPERIOR FORM BUILDERS,

Plaintiff,

ACTION NO. 2:93cv940

DAN CHASE TAXIDERMY SUPPLY CO., INC.,
DAN CHASE,

Defendants.

MEMORANDUM OPINION

I. Facts and Procedural History

Plaintiff filed this suit alleging copyright infringement by defendants. Plaintiff is the owner of four copyrights that have been registered with the United States Copyright Office for taxidermy forms or mannequins: two raccoons, a deer, and an otter. The forms are made through a multi-step process. First, the sculptor studies live animals. Then, he uses an animal carcass to make a plaster "death mask" for study purposes. He then sculpts an animal in a certain pose out of clay put over an armature. Next, the clay animal is made into a mold, which is used to create

polyurethane copies of the form. Plaintiff alleged that defendants, under the guise of a false name, ordered these four forms,[1] removed plaintiff's copyright notice, copied the forms, and placed their own copyright notice on the copies. Defendant Dan Chase admitted that he "utilized" plaintiff's forms but denied the copying.

Defendants moved for summary judgment on the grounds that these taxidermy forms were not properly copyrightable under the Copyright Act, which motion was denied by this court on May 10, 1994. The case proceeded to trial before a jury on May 12, 1994. On May 17, 1994, the jury returned a verdict in favor of plaintiff, awarding maximum statutory damages in the amount of $400,000.00. On June 16, 1994, plaintiff moved for an award of attorney's fees and submitted a memorandum in support of that motion. On June 30, 1994, defendants submitted a memorandum in opposition to the motion. A hearing was held on July 25, 1994. The motion for attorney's fees is now ripe for decision.

II. Analysis

A. Whether to Award

Section 505 of the Copyright Act provides that "[i]n any civil action under this title, the court in its discretion may ... award a reasonable attorney's fee to the prevailing party as part of the costs." 17 U.S.C. § 505. The award of an attorney's fee to a prevailing party is thus within the trial court's discretion; however, such an award should not be

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[1]Plaintiff sells the polyurethane forms to taxidermists, who use them for mounting skins

made as a matter of course. Fogerty v. Fantasy, Inc., 114 S. Ct. 1023, 1033 (1994). In the Fourth Circuit, the rule is that a district court should look at four factors in deciding whether to award attorney's fees under section 505: "(1) 'the motivation of the parties,' (2) 'the objective reasonableness of the legal and factual positions advanced,' (3) 'the need in particular circumstances to advance considerations of compensation and deterrence,' and (4) 'any other relevant factor presented.'" Diamond Star Bldg. Corp. v. Sussex Co. Builders, Inc., 21 F.3d 59, 61 (4th Cir. 1994), quoting Rosciszewski v. Arete Assocs., Inc., 1 F.3d 225, 234 (4th Cir. 1993). Applying these factors, the court GRANTS plaintiff's motion for attorney's fees.

The first element to be taken into consideration is the motivation of the party from whom attorney's fees are sought. Diamond Star, 21 F.3d at 61. "While a finding of willful infringement or bad faith on the part of the opposing party may be considered by the district court, the presence or absence of such motivation is not necessarily dispositive." Rosciszewski, 1 F.3d at 234. In this case, the jury quickly found that defendants had acted willfully in infringing plaintiff's copyrights. Therefore, although it is not dispositive, this factor weighs heavily in favor of awarding attorney's fees to plaintiff.

The court must also consider the objective reasonableness of the legal and factual positions advanced by the parties, "whether the positions advanced were frivolous, on the one hand, or well-grounded in law and fact, on the other." Id. Defendants' legal position in this case was based on a copyright case from another federal district court in Alabama, which involved fish forms. Thus, defendants took a case from another jurisdiction, involving a completely

different set of facts, and argued that this case was analogous to the case at bar and that this court was required to accept that opinion. While their position may not have been frivolous, it was definitely not well-grounded in law and fact. Furthermore, even after this court upheld the copyrightability of the taxidermy forms in this case, defendants persisted in their position that the forms were not copyrightable and continued to contest every aspect of the case, whether such argument was tenable or not. The court had to review repeatedly its previous legal rulings with defense counsel. Because the legal and factual positions of defendants were not objectively reasonable, particularly after the court denied summary judgment, this factor also weighs in favor of a fee award.

The next element to evaluate is the need to advance considerations of compensation and deterrence. Id. Defendant has been involved in copyright suits for years. In fact, there are currently suits pending against Mr. Chase and his company in other jurisdictions for copyright infringement of this exact same type. Only substantial awards of damages as well as attorney's fees will deter Mr. Chase from continuing this willful and outrageous conduct. Moreover, the plaintiff deserves to be compensated for his attorney's fees. As a small businessman, it was very costly for him to retain the quality type of attorney that was needed to prosecute an intellectual property case. In short, considerations of compensation and deterrence do not justify an award of attorney's fees in this case.

Finally, the court may consider any other relevant factor. Diamond Star, 21 F.3d at 62. This case presented legal questions that were novel and complex. However, defendants made this case more difficult by their continued

attempts during trial to confuse the jury with irrelevant and settled issues. If defendants had concentrated solely on the important issues in the case, trial could have been avoided; at the very least, the length of the trial could have been decreased. Being largely responsible for the amount of plaintiff's attorney's fees, it is only fair that defendants bear the cost of their actions by paying those fees.

B. Amount of Award

The Supreme Court has instructed that "[t]he most useful starting point for determining the amount of a reasonable fee is the number of hours reasonably expended on the litigation multiplied by a reasonably hourly rate." Hensley v. Eckerhart, 461 U.S. 424, 433 (1983). In order to define the variables for this calculation, which is also known as the lodestar figure, the court should consider the factors in Johnson v. Georgia Highway Express, Inc., 488 F.2d 714, 717-19 (5th Cir. 1974). Daly v. Hill, 790 F.2d 1071, 1077 (4th Cir. 1986).[2] The factors in determining the reasonable rate and the reasonable hours include:

> (1) the time and labor required; (2) the novelty and difficulty of the questions; (3) the skill requisite

[2]The Fourth Circuit adopted the Johnson factors as part of its lodestar analysis in Barber v. Kimbrell's, Inc., 577 F.2d 216, 226 (4th Cir.), cert. denied, 439 U.S. 934 (1978). However, the Fourth Circuit used these factors to enhance or decrease the award of attorney's fees. Following the Supreme Court's decision in Blum v. Stenson, 465 U.S. 886, 900-02. (1984), the Fourth Circuit in Daly found that it had been misapplying the Johnson factors. Daly, 790 F.2d at 1077. Accordingly, the Fourth Circuit held that the Johnson factors should be considered in determining the lodestar figure, rather than in enhancing or decreasing fee awards after the lodestar figure had been calculated.

> to properly perform the legal service; (4) the preclusion of other employment by the attorney due to acceptance of the case; (5) the customary fees; (6) whether the fee is fixed or contingent; (7) time limitations imposed by the client or the circumstances; (8) the amount involved and the results obtained; (9) the experience, reputation, and ability of the attorneys; (10) the 'undesirability' of the case; (11) the nature and length of the professional relationship with the client; and (12) awards in similar cases.

Daly, 790 F.2d at 1075 n.2. If this formula results in a fee that is either unreasonably low or unreasonably high, the district court may then adjust the fee as necessary within the guidelines of the Johnson factors. Blum v. Stenson, 465 U.S. 886, 897 (1984).

The determination of both the reasonable hourly rate and the reasonable number of hours expended requires separate consideration for each person billing hours to the client. The attorneys who appear on the itemized billing statements include: Gregory Giordano, a partner in the law firm of Shuttleworth, Ruloff, Giordano and Kahle, P.C. ("Shuttleworth, Ruloff"), Lawrence H. Woodward, an associate with Shuttleworth, Ruloff, and F. Prince Butler, a partner in the law firm of Griffin, Butler, Whisenhunt and Kurtossy, P.C. P1's Mot. for Atty's Fees and Costs and Br. Supp. ("PI's Mot. for Fees"), Exs. A, B. Several paralegals and a law clerk from Shuttleworth, Ruloff also appear on the billing statement. PI's Mot. for Fees, Ex. A. As long as it is the practice of the attorney and the community to bill the client for the hourly work of employees such as law clerks and paralegals, then reasonable hourly charges to the client

for those persons are properly included as part of the attorney's fees award. See Missouri v. Jenkins, 491 U.S. 274, 264 (1989).

The party seeking attorney's fees bears the burden of "establish[ing] the reasonableness of the requested rate." Plyler v. Evatt, 902 F.2d 273, 277 (4th Cir. 1990). It is also required that, "[i]n addition to the attorney's own affidavits, the fee applicant must produce satisfactory 'specific evidence of the "prevailing market rates in the relevant community" for the type of work for which he seeks an award.'" Id. Plaintiff's attorneys have submitted detailed, itemized billing statements, their own affidavits, affidavits from Tidewater area attorneys and Northern Virginia area attorneys, 1993 Economic Survey Reports of billing rates and copyright litigation costs published by the American Intellectual Property Law Association, other news articles concerning the attorneys, and itemized expense statements. Defendants have not submitted any evidence with which the court could make a determination of a reasonable hourly rate or the reasonable number of hours spent on this case. In addition to considering materials submitted by the parties, the court may, on its own, review the billing statement for reasonableness. See Spell v. McDaniel, 616 F. Supp. 1069, 1085 (E.D.N.C. 1985), aff'd in part, vacated in part, on other grounds, 824 F.2d 1380 (4th Cir. 1987), cert. denied, 484 U.S. 1027 (1988).

1. Johnson factors

Johnson factors one, two, three, four, five, six, eight, nine, ten, eleven, and twelve pertain to the determination of the reasonable hourly rate and the reasonable hours spent in this case. See Trimmer v. City of Norfolk, 846 F. Supp.

1295 (E.D. Va. 1994). The court will consider each relevant factor and its impact on the reasonable hourly rates or on the reasonable number of hours expended.

(1) *The time and labor required.* This copyright litigation has involved responding to a motion for summary judgment, rebutting a motion in limine, preparing for trial through discovery, participating in a four day jury trial, responding to a motion for a new trial, and submitting an attorney's fee petition. This case necessitated the time and labor of three attorneys and assistance from paralegals and a law clerk. Plaintiff's attorneys have submitted affidavits, which certify the reasonableness of the hours spent on the case by the members of Shuttleworth, Ruloff. Brydges Aff. ¶ 3; Drescher Aff. ¶ 3; Weinberg Aff. ¶ 3. Similar affidavits from Northern Virginia attorneys verify that Mr. Butler's bill conformed to the "customary" charges. Baker Aff.; Burnam Aff. ¶ 7.

Mr. Giordano's experience in complex litigation and Mr. Butler's specialization in copyright law reduced the total time and labor required for this case. See Giordano Aff. ¶ 7; Butler Aff. This reduction in total number of hours supports awarding fees for the requested number of hours from both of these attorneys.

However, the court finds that several particular items on the itemized bill from Shuttleworth, Ruloff are not reasonable. Defendants challenge 2.5 hours spent by Mr. Giordano on November 22, 1993 for a pretrial conference as unwarranted. See Pl's Mot. for Fees, Ex. A. Based on the court's docket records, no pretrial conference occurred on that date. However, the billing statement description for those 2.5 hours also includes review of discovery and client

letter activities by Mr. Giordano. Because the court concludes that those activities would reasonably consume 1 hour, the court will subtract only 1.5 hours from Mr. Giordano's total to correct that billing error.

The billing statement lists 0.3 hours taken by Mr. Woodward to review and sign an order for an extension of time. The referenced order contains only one short paragraph. A more reasonable estimate, based on the court's own experience, is 0.1 hours.

The Shuttleworth, Ruloff bill designates 26.5 hours as time spent digesting depositions by several paralegals. Because the attorneys attended the depositions, the time taken to summarize these documents is duplicative and not reasonable. The court will subtract these hours from the ones included in the Shuttleworth, Ruloff billing statement.

Clerical tasks performed by various paralegals on April 6th, May 6th, 9th, and 10th consumed 12 hours. An attorney may not bill at his hourly rate for secretarial tasks just because he performs them. See Johnson, 488 F.2d at 717. By analogy, just because paralegals have performed clerical tasks, such as photocopying and assembling binders, hours spent on these activities should not be billed at the paralegal's hourly rate. In the Shuttleworth, Ruloff billing statement, each time that clerical activities are listed, they appear in the same phrases as a description of paralegal time spent in preparation for the summary judgment hearing or for trial. Because the plaintiffs have not clearly identified how much time the paralegals allocated to each activity, the court will deduct half of the time expended by paralegals on April 6th, May 6th, 9th and 10th to account for clerical activities.

The bill also reflects a charge for paralegal time spent at trial. Although charges for paralegal assistance are permissible, these charges exceed what is reasonable because of the presence of two attorneys at each day of the trial. The billing statement description does not indicate that the paralegal did anything other than attend the trial. Plaintiff's attorneys have not met their burden in demonstrating the reasonableness of these hours, and the court determines that the presence of a paralegal at trial was superfluous.

Included in the billing statement are charges arising from research and other tasks performed by the law clerk. The law clerk expended 14 hours researching attorney's fees and 22.5 hours researching an advice of counsel issue and a new trial motion. Based on the facts and circumstances from this case, only one-half of those hours would ordinarily be required to research adequately those topics. Consequently, the total hours expended by the law clerk will be reduced by one half.

(2) *The novelty and difficulty of questions involved.* This litigation involved new and complex questions of copyright law, including the copyrightability of taxidermy forms, for which no precedent existed in the Fourth Circuit. In addition, the jury trial lasted four days and involved technical evidence concerning the creation of taxidermy forms. This factor favors the reasonableness of the requested hourly rates.

(3) *The skill requisite to perform the legal service properly.* This case required lawyers with particular skills in both the substantive area of copyright law and in complex litigation. Plaintiff properly employed lawyers with these separate skills and should collect fees for hours spent by both attorneys on this case.

(4) *The preclusion of other employment by the attorney due to the acceptance of the case.* Because of the time dedicated to thoroughly responding to defendant's motions, Mr. Giordano claims that other cases were put on the "back burner." In addition, Mr. Giordano's earnings depend on the number of cases for which he receives compensation. The fact that this case spanned ten months and consumed almost 280 hours of his time supports the reasonableness of an award at his regularly claimed rate.

(5) *The customary fee.* Affidavits support that the hourly rates for all employees billing from Shuttleworth, Ruloff were reasonable. Brydges Aff. ¶ 3; Drescher Aff. ¶ 3; Weinberg Aff. ¶ 3. In the 1993 Report of Economic Survey, Mr. Giordano's rate falls slightly below the median rate charged by partners in private law firms for both the East and Southeastern regions. Pl's Mot. for Fees, Ex. M. Defendants have not specifically objected to any of the hourly rates contained in the billing statements.

While affidavits support the overall reasonableness of the Shuttleworth, Ruloff billing statement, the affidavits do not address individually the specific qualifications or contributions of Mr. Woodward. On the 1993 Report of Economic Survey, Mr. Woodward's rate, as an associate in a private law firm, falls above the median rate for both the East and Southeastern regions. Pl's Mot. for Fees, Ex. M. By contrast, Mr. Giordano, who works for the same law firm, charges a rate which falls slightly below the median figure on the same chart. A downward adjustment of Mr. Woodward's rate will reflect a more reasonable hourly rate, which corresponds to the rate level charged by this law firm.

Affidavits and the 1993 Report of Economic Survey

support the reasonableness of the hourly rate charged by Mr. Butler for his intellectual property and copyright expertise. Baker Aff.; Burnam Aff. ¶ 7; Pl's Mot. for Fees, Ex. P. Mr. Butler charges the same $220.00 hourly rate to clients regardless of the market in which he provides representation. The court finds that the hourly rate charged by Mr. Butler conforms to the customary fees charged in such cases.

Plaintiffs have permissibly included the hourly charges for paralegals and law clerks in a request for attorney's fees. See Jenkins, 491 U.S. at 284. In this case, the affidavits generally support the fairness of the billing statement, without stating whether it is community practice to bill for these persons or what are the prevailing rates for law clerks or for paralegals. Defendants have offered no evidence to rebut the reasonableness of these rates. Based on the court's own experience, such charges conform to the practice of this community, and the rates charged for these persons are reasonable.

(6) *Whether the fee is fixed or contingent*; (10) *The undesirability of the case.* The court will apply Johnson factors six and ten to this case together. Plaintiff's attorneys accepted this case on a contingency basis. Plaintiff's attorneys claim that, while this case was not undesirable, it may have been undesirable to handle such a case based on a contingency fee. Giordano Aff. ¶ 8. Having accepted this case on a contingency basis, counsel expected fees to be awarded in this case in the event that the plaintiff prevailed. See Johnson, 488 F.2d at 716. The contingency arrangement favors awarding plaintiff's attorneys the requested value of their services, because they accepted this case with the possibility that they would not receive compensation.

(8) *The amount involved and the results obtained.* Plaintiff prevailed at the trial level and obtained $400,000.00, the maximum amount of statutory damages for four copyright violations. Importantly, the case established plaintiff's right to compete in the taxidermy industry and his right not have his work pirated by suppliers. This determination favors an award at the requested hourly rates for the hours spent in realizing those results.

(9) *The experience, reputation, and ability of the attorneys.* Mr. Giordano enjoys a good reputation, and his ability is respected in the community. Giordano Aff ¶ 5; Weinberg Aff. ¶ 4; Pl's Mot. for Fees, Ex. N. In the affidavits, the attorneys, including Mr. Giordano, also attest specifically to his experience in complex litigation. Giordano Aff. ¶ 3; Brydges Aff. ¶ 4; Drescher Aff.¶ 4; Shumadine Aff. ¶ 4; Barr Aff. ¶ 4; Weinberg Aff. ¶ 4. Mr. Butler maintains an established practice in intellectual property law both in Northern Virginia and in Tidewater. Baker Aff.; Burnam Aff. ¶ 6. The experience of these attorneys allowed them to deliver quality services for the time that they devoted to this case; this fact favors the reasonableness of the requested hourly rates for these two attorneys.

Additionally, this factor also favors a downward adjustment in Mr. Woodward's hourly rate. Plaintiff's attorneys assert that Mr. Woodward has ten years of litigation experience. However, no affidavits or other exhibits support a rate for Mr. Woodward in excess of the median rate for general litigation practice by an associate in a private law firm.

(11) *The nature and length of the professional relationship with the client.* Mr. Butler handled the initial

filing of the plaintiff's copyrights. Despite this fact, the plaintiff did not receive a special rate from any of the attorneys involved with the case. Therefore, this factor does not affect the reasonableness of the requested rates.

(12) *Awards in similar cases.* Copyright awards vary depending on the particular facts of an individual case. See Nimmer, The Law of Copyright § 14.10[C] n.19 (1991). Plaintiff's attorneys have attached the 1993 Report of Economic Survey to their brief, which indicates an $80,000.00 median charge for copyright litigation through trial level for the Southeastern region. Although this charge does not directly reflect awarded amounts in copyright cases, it does incorporate the product of the hourly rate and the hours expended. This figure reflects the typical cost of such litigation to a client, and plaintiff's requested amount resembles this median figure. Pl's Mot. for Fees, Ex. P.

Based on the above considerations, the following are reasonable rates, hours, and fees for each of the persons contributing to the attorney work product of this case:

	Hours	x	Rate	=	Fee
Gregory Giordano, Esquire	276.80		$175.00		$48,440.00
F. Prince Butler, Esquire	56.00		$220.00		$12,320.00
Lawrence H. Woodward, Esquire	49.10		$120.00		$ 5,892.00

Kate McGrath (paralegal)	15.00	$ 55.00	$ 825.00
Carla Ellis (paralegal)	0.00	$ 55.00	
Judi Sands (paralegal)	0.00	$ 55.00	
Beverly Rebar (law clerk)	18.25	$ 65.00	$ 1,186.25
Total -- **Lodestar figure**			$68,663.75

Counsel have agreed in a letter to the court to deduct the sum of $262.50 from the attorney's fees request. Letter dated August 17, 1994, from Gregory Giordano to the court, at 2 (no reason given for deduction in letter). This amount is therefore deducted from the lodestar figure so that the court awards a fee of $68,400.75, based on billable hours and for the reasons set forth above. Defendants have requested that the court make an award that is fair and just. To reach this decision, no additional consideration of the Johnson factors is required.

2. Amount of costs

In determining an award of attorney's fees, "[l]itigation expenses, such as supplemental secretarial costs, copying, telephone costs, and necessary travel, are integrally related to the work of an attorney..." and, thus, are

compensable. Wheeler v. Durham City Bd. of Educ., 585 F.2d 618, 623-24 (4th Cir. 1978) (attorney's fees awarded as a part of costs in 20 U.S.C. § 1617 action); Daly, 790 F.2d at 1083 (attorney's fees awarded as a part of costs in 42 U.S.C. § 1988 action). This rule extends to awards of attorneys fees in copyright cases. See 17 U.S.C. § 505 (providing for "a reasonable attorney's fee to the prevailing party as a part of the costs."). In addition, because computer assisted research will reduce the number of hours an attorney must dedicate to a case, those charges comprise part of the costs. Wehr v. Burrouahs Corp., 619 F.2d 276, 284 (3d Cir. 1980); accord International Woodworkers v. Champion Int'l Corp., 790 F.2d 1174, 1185 (5th Cir. 1986), aff'd sub nom. Crawford Fitting Co. v. J.T. Gibbons, Inc. 482 U.S. 437 (1987); but see Leftwich v. Harris-Stowe State College, 702 F.2d 686, 695 (8th Cir. 1983).

Plaintiff requests reimbursement for such litigation expenses. Specifically, the billing statement from Shuttleworth, Ruloff reflects $4,911.56 in costs for filing, service, color graphics, federal express, photocopying, travel expenses, and transcripts. Pl's Mot. for Fees, Ex. Q. Mr. Butler's billing statement included charges for long distance telephone calls, telefax, photocopies, patent copies, certification fees, a Dun and Bradstreet report, computer research, and postage. Pl's Mot. for Fees, Ex. R. The expenses submitted by Griffin, Butler, Whisenhunt & Kurtossy, P.C. total $792.19.[3] Id.

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[3]Plaintiff's attorneys state that the expenses incurred by Prince Butler total $946.29; however, the expense statement from Griffin, Butler, Whisenhunt & Kurtossy, P.C. lists only $792.19 in expenses. Compare Pl's Mot. for Fees at 15 with Pl's Mot. for Fees, Ex. R.

Defendants objected only to the inclusion of charges for the depositions taken. "A district court should award costs [for depositions] when the taking of a deposition is reasonably necessary at the time of its taking." La Vay Corp. v. Dominion Fed. Savs. & Loan Ass'n, 830 F.2d 522, 528 (4th Cir. 1987), cert. denied, 484 U.S. 1065 (1988). Defendants do not address any particular depositions that were not necessary.

Each deponent contributed to the strength of plaintiff's response to the defendant's summary judgment motion and to the plaintiff's case at trial. Witnesses interviewed by the plaintiff's attorneys assisted plaintiff's discovery by developing allegations of the complaint and by testifying to the artistic merit of the plaintiff's work and the taxidermy industry. Defendants also offer no support for the assertion that it is the custom and practice in this district only to allow deposition costs for complex litigation or other special situations. Costs of the depositions as well as other charges conform to those expenses reasonably associated with the cost of litigation.

The court finds that all items taxed as costs were reasonable, necessary, and related to the presentation of the case. Accordingly, the court reviewed Plaintiff's statements of expenses and the court finds the items therein to be reasonable. Therefore, the court awards costs of $5,703.75 to the Plaintiff.

III. Conclusion

Upon a balancing of the factors relevant to the issue of attorney's fees as set out in Diamond Star, the court finds that an award of such fees in this case is justified.

Therefore, plaintiff's motion for attorney's fees and costs is GRANTED in the amount of $74,104.50.

The Clerk is DIRECTED to send a copy of this Memorandum Opinion to all counsel of record.

It is so ORDERED.

/s/ Rebecca BeachSmith
UNITED STATES DISTRICT JUDGE

Norfolk, Virginia

September 16, 1994

APPENDIX G

UNITED STATES DISTRICT COURT
Eastern District of Virginia
Norfolk Division

JUDGMENT IN A CIVIL CASE

SUPERIOR FORM BUILDERS

v. CASE NUMBER: 2:93cv940

DAN CHASE TAXIDERMY SUPPLY CO., INC., DAN CHASE

Jury Verdict. This action came before the Court for a trial by jury. The issues have been tried and the jury has rendered its verdict.

X Decision by Court. This action came to ~~trial or hearing~~ decision before the Court. The issues have been ~~tried or heard~~ decided and a decision has been rendered.

IT IS ORDERED AND ADJUDGED that defendants' motion for a new trial is DENIED.

August 5, 1994 — DORIS R. CASEY *Date*
Clerk

/s/ Rhonda D. Lambert
(By) Deputy Clerk
(Rhonda D. Lambert)

APPENDIX H

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
Norfolk Division

SUPERIOR FORM BUILDERS,

Plaintiff,

v. ACTION NO. 2:93cv940

DAN CEASE TAXIDERMY SUPPLY CO., INC., DAN CHASE,

Defendants.

MEMORANDUM OPINION

I. Facts and Procedural History

Plaintiff filed this suit alleging copyright infringement by defendants. Plaintiff is the owner of four copyrights that had been registered with the United States Copyright Office for taxidermy forms or mannequins: two raccoons, a deer, and an otter. The forms are made through a multi-step process. First, the sculptor studies live animals. Then, he uses an animal carcass to make a plaster "death mask" for study purposes. He then sculpts an animal in a certain pose out of clay put over an armature. Next, the clay animal is made into a mold, which is used to create polyurethane copies of the form. Plaintiff alleged that defendants, under

the guise of a false name, ordered these four forms,[1] removed plaintiff's copyright notice, copied the forms, and placed their own copyright notice on the copies. Defendant Dan Chase admitted that he "utilized" plaintiff's forms but denied the copying.

Defendants moved for summary judgment on the grounds that these taxidermy forms were not properly copyrightable under the Copyright Act, which motion was denied by this court on May 10, 1994. The case proceeded to trial before a jury on May 12, 1994. On May 17, 1994, the jury returned a verdict in favor of plaintiff, awarding damages in the amount of $400,000.00. On June 1, 1994, defendants moved for a new trial and submitted a memorandum in support of that motion. On June 10, 1994, defendants submitted a revised version of their memorandum. On June 15, 1994, plaintiff responded. Defendants replied on June 23, 1994. This motion is now ripe for decision.

II. Analysis

A. Standard

Rule 59 of the Federal Rules of Civil Procedure provides that a new trial may be granted "for any of the reasons for which new trials have heretofore been granted in actions at law in the United States ...." The decision to grant or deny a Rule 59 motion is largely within the purview of the trial judge, for "[t]he authority to grant a new trial ... is confided almost entirely to the exercise of discretion on the part of the trial court." Allied Chem. Cord. v. Daiflon,

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[1] Plaintiff sells the polyurethane forms to taxidermists, who use them for mounting skins.

Inc., 449 U.S. 33, 36 (1980) (per curiam). See also Aetna Casualty & Surety Co. v. Yeatts, 122 F.2d 350, 354 (4th Cir. 1941) ("granting or refusing of a new trial is a matter resting in the sound discretion of the trial judge"). However, it is the duty of the court to grant the motion if denial would result in a miscarriage of justice, and a judge therefore "should not hesitate to ... grant a new trial in any case where the ends of justice so require." Id. at 352, 354.

A motion for a new trial may be granted for any of a number of reasons.

> Though the underlying basis for a new trial is always "to prevent injustice," there are a number of specific injustices which a court may find in support of a Rule 59 motion. These include a prejudicial error of law on the part of the court, a verdict which is against the weight of the evidence, damages awarded which are either too large or too small, or some palpable misconduct which has prejudicially affected the jury.

Allred v. Maersk Line, Ltd., 826 F. Supp. 965, 969 (E.D. Va. 1993). It is up to the court to weigh the evidence and any other factors which are pertinent to the motion before exercising its independent judgment as to the need for a new trial. Poynter v. Ratcliff, 874 F.2d 219, 223 (4th Cir. 1989); Williams v. Nichols, 266 F.2d 389, 393 (4th Cir. 1959). However, the moving party, defendants in this case, have the burden of proof to show harmful error which would require a new trial. Ward v. City of San Jose, 737 F. Supp. 1502, 1513 (N.D. Cal. 1990), aff'd in part, rev'd in part on other grounds, 948 F.2d 1097 (9th Cir. 1991). Furthermore, "[a] motion for a new trial should not be granted ... where the moving party has failed to timely object to the alleged impropriety giving rise to the motion." Dennis v. General

Elec. Corp., 762 F.2d 365, 367 (4th Cir. 1985). Here, there has been no error committed which would require a new trial. Moreover, defendants inexcusably failed to object to some of the very "mistakes" which they now claim deprived them of a fair trial. Because defendants cannot bear the burden of showing that a new trial is required in this case, the motion for a new trial is DENIED.

B. Validity of the Copyrights

Defendants make a number of claims of error dealing with their defenses to the validity of plaintiff's copyrights. Defendants claim, first, that a new trial is required because the court excluded evidence that plaintiff's works were not original, but were copied from pre-existing works or works in the public domain.[2] Basically, defendants disagree with this court's ruling that there was no issue of material fact as to originality to present to the jury. This argument was fully presented at trial. At that time, the court ruled that defendants had admitted the originality of

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[2] Defendants also note that the court said, during defense counsel's opening statement, "Well, they are copyrightable. They have been copyrighted. He has copyrights on them. They are valid copyrights." Tr. at 57. The defendants argue that the statement that the copyrights were valid was improper; however, the defendants misconstrue the court's statement. The court was referring to the copyright registrations, which were unquestionably valid. To the extent that the comment in question was a misstatement on the part of the court, the error was clearly harmless. The court later ruled that the works in question were original, removing that argument as a defense to validity. The other argument about validity involved the authorship of form SRC-4A, the standing raccoon. The court allowed evidence as to this issue, and submitted the issue to the jury. See infra at 7; see also Tr. at 623-24.

plaintiff's forms by admitting that he had made the forms from observing nature and that he had sculpted the original surface features himself. See Tr. at 122-30; 145-59. Normally, a Rule 59 motion for a new trial may not be used merely to rehash the same arguments made by the parties at trial. Keyes v. Nat'l R.R. Passenger Corp., 766 F. Supp. 277, 280 (E.D. Pa. 1991); Milwee v. Peachtree Cypress Investment Co., 510 F. Supp. 284, 289-90 (E.D. Tenn. 1978). Even if this court were to reconsider these arguments, no relief from the jury verdict would be warranted.

The threshold of originality required for copyright protection is very low; it does not require novelty or striking uniqueness. Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345-46 (1991); L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 490 (2d Cir.), cert. denied, 429 U.S. 857 (1976). See also Kamar Intern., Inc. v. Russ Berrie and Co., 657 F.2d 1059, 1061 (9th Cir. 1981) (basing sculpture on live animal does note deprive it of originality). In this case, defendants admitted that plaintiff had added original surface features, at the very least, to his forms. Such originality alone would be sufficient to allow copyright protection.[3] Thus, no error was made in the ruling of the court that originality was not in issue.

Defendants' reliance on Feist is misplaced. Defendants cite that case for the proposition that "the [illegible]e

[3] In fact, in their reply, defendants state that "there is no dispute that ... SFB's works contained the sufficient 'modicum of originality' to satisfy the threshold test for copyright protection." Defendants' Reply to Plaintiff's Opposition to Motion for New Trial ("Defendants' Reply") at 1.

fact that a work is copyrighted does not mean that every element of the work may be protected." 499 U.S. at 348. However, that statement by the court dealt with the specific problem of the copyrightability of a compilation of facts. The court noted that while the individual facts may not be protected, the work as a whole could be capable of possessing originality. Id. A compilation of facts, though, is very different from the sculptural works that were at issue in this case. It is still true, of course, that originality is required; however, defendants' attempts to divide the sculptures into "pose," "attitude," "expression," "surface features," and so forth, are misguided. For a sculpture, the requisite originality will render the entire sculpture copyrightable. Unlike factual compilations, sculptures are not properly viewed as divisible into separate pieces of a whole.[4]

Next, defendants complain that the court prevented them from presenting their defense that plaintiff was not the author of the works in question. They also claim that the court prevented them from showing that the works of plaintiff and defendants were not substantially similar. As to these two claims, defendants allege that the court made improper comments and asked improper questions of the witnesses. Defendants' arguments are completely without merit.[5] First, defendants did not at any point object to a

[4] Furthermore, the evidence that defendants wished to present on originality through Mr. Knight was not the best evidence. See Tr. at 158.

[5] The court notes that, in at least one instance, defendants' initial memorandum misstates the facts. Defendants claim that the court, in

(continued...)

question or a comment made by the court. Therefore, they have waived any error that may have occurred. Dennis, 762 F.2d at 367. The mere fact that the objectionable question or comment was made by the judge does not relieve the party of the necessity of objecting. Fed. R. Evid. 614(c).

Second, none of the comments or questions pointed to by defendants was improper. These statements merely served to develop the facts of the case and ensure that the jury was not confused. A trial judge

> "sits to see that justice is done in the cases heard before him; and it is his duty to see that a case on trial is presented in such way as to be understood by the jury, as well as by himself. He should not hesitate to ask questions for the purpose of developing the facts; and it is no ground of complaint that the facts so developed may hurt or help one side or the other."

Pollard v. Fennell, 400 F.2d 421, 424 n.1 (4th Cir. 1968), quoting Simon v. United States, 123 F.2d 80, 83 (4th Cir.), cert. denied, 314 U.S. 694 (1941). The statements by the court in this case did not prevent defendants from presenting evidence that plaintiff was not the author of one of the

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[5](...continued)
front of the jury, stated, "What difference does it make if Joe Doe made the forms if they are copyrighted and he holds the copyrights? Don't throw all these red herrings out there before this jury and in this kind of case." In fact, the court did make this statement, but made it at sidebar, not in front of the jury. Tr. at 58. Defendants admit this mistake in their reply. See Defendants' Reply at 23.

raccoon forms or that the plaintiff's forms and the defendants' forms were not substantially similar. In fact, the first question on the special verdict form presented to the jury involved the authorship of the standing raccoon form. Thus, the court's comments complained of by defendants on this matter are not grounds for a new trial.[6] Defendants were in no way prevented from challenging the validity of plaintiff's copyrights.

C. Jury Instructions on Originality

Defendants next allege that the court's instructions on originality were confusing to the jury. Specifically, they argue that Instructions 14, 18, and 21 were confusing when read in conjunction with Instruction 19. Any objection to jury instructions must be made before the jury retires. Fed. R. Civ. P. 51. In this case, defendants never objected to Instruction 18, and, in fact, that instruction was submitted by defendants. They cannot now complain that the instruction was confusing or misleading when they had no objection to it at the time of trial.

Likewise, defendants did not object to Instruction 21 as it was given to the jury. Defendants made an objection to Instruction 21 as it was originally proposed. Tr. at 543. The court responded by removing the last paragraph of the instruction. Tr. at 544. The following dialogue then occurred:

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[6] For a further discussion of the propriety of comments by the court, see Section G, infra.

THE COURT: You are on 21, and I pulled out the last paragraph. What's your objection now?

MS. HOLT: I wanted to make it clear.

THE COURT: What's your objection to 21?

MS. HOLT: I stated my objection.

THE COURT: I pulled out the paragraph. Do you have any objection to it now?

MS. HOLT: Not any other objections to 21.

THE COURT: So 21 suits you? There is no objection on the record to instruction 21?

MS. HOLT: No, Your Honor.

THE COURT: Okay.

MS. HOLT: Other than what you have already corrected.

Tr. at 545. After such an extensive discussion, defendants cannot with a "straight face" now allege that they objected to Instruction 21.

However, defendants did object to Instructions 14 and 19, arguing that they were inconsistent "as far as I found them to be original and then only the original aspects are subject to protection." Tr. at 542. These instructions are in

no way inconsistent or confusing. In fact, even if the court were to consider the allegations with regard to Instructions 18 and 21, no new trial would be granted; the instructions simply did not mislead the jury. In Instruction 14, the court merely explained to the jury the nature of copyright law in an effort to give them an overview of what considerations were involved in such a case. Tr. at 619-621. In Instruction 18, the court listed the elements that were necessary for plaintiff to prove the validity of its copyright. Tr. at 623-24. The court then told the jury, in Instruction 19, that one of the elements had been found by the court to have been proved as a matter of law. Tr. at 624-25. Finally, in Instruction 21, the court instructed the jury that liability only existed if original aspects of the plaintiff's works were copied. Tr. at 626. This instruction was merely a true statement of copyright law. Defendants have not shown that, nor explained how, these instructions, read in context and taken as a whole, confused the jury in any way.

D. Advice of Counsel

Defendants' next ground for a new trial is that the court erred in excluding evidence that defendants had relied on the advice of counsel that the mannequins were not subject to copyright protection. The first time that a question was asked about the advice of counsel was during plaintiff's case-in-chief. Plaintiff called defendant, Dan Chase, as an adverse witness, and, after Mr. Chase denied knowing an aspect of copyright law, asked him, "Attorneys never told you that, all these attorneys you've had over the years?" Tr. at 255. Defendants objected to the question, which the court sustained.

Later, during defendants' case, Mr. Chase was again called as a witness. His previous experience in copyright

cases was discussed. Defense counsel asked Mr. Chase if he had taken any action, in the past, when other people worked off of his taxidermy forms. Tr. at 442. Mr. Chase replied that he had not. Id. Counsel then asked, "Why not?" Id. Mr. Chase answered,

> Well, earlier in my career I paid I know of two different lawyers that are both in the field of copyright and went over taxidermy mannequins and went over how the law read and though we were putting the copyright symbol on and so forth for protection, if we needed it. The consensus of these two attorneys --

Id. At this point, the court stopped Mr. Chase's testimony and informed counsel that it would be improper for Mr. Chase to offer the legal conclusions of his attorneys as evidence. Tr. at 443. However, the court specifically told counsel that it might be acceptable for Mr. Chase to "say that he never proceeded on them because he was of the opinion that it was okay to copy them." Id.[7]

For a number of reasons, the court's exclusion of the testimony of Mr. Chase on this point does not entitle defendants to a new trial.[8] First, defense counsel cannot

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[7] The court offered defense counsel the opportunity to explain the propriety of the question when the jury was on its lunch break, with the possibility of reasking the question later if it was found to be relevant. Tr. at 443. Defense counsel did not avail herself of this option. See infra at 11-12.

[8] Defendants also challenge two comments of the court, made during Mr. Rinehart's testimony, Tr. at 493, and during plaintiff's (continued...)

have it both ways. They cannot object to a question when asked by plaintiff's counsel and then try to offer the evidence at their convenience. Second, in refusing to allow the legal opinions of the attorneys, the court prevented defendants from confusing the jury through a suggestion that the forms were not copyrightable, when that legal issue had been decided by the court at the summary judgment stage. See Tr. at 57 ("I have ruled on May 10, 1994 in a written opinion that these forms are copyrightable. And that's a dead issue in this cases as far as I'm concerned ...."). Defense counsel repeatedly, throughout the trial, attempted to defy and ignore this court's legal ruling on this issue on summary judgment.

Third, no offer of proof was ever made by defendants on this point. A party cannot claim error as to a ruling which excludes evidence unless "the substance of the evidence was made known to the court by offer or was apparent from the context within which questions were asked." Fed. R. Evid. 103(a) (2). In this case, all that is known from the context is that the attorneys advised Mr. Chase that some type of taxidermy form was not capable of protection under the copyright laws. The court specifically

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[8](...continued)
closing argument, Tr. at 562. Neither of these comments was objected to at trial, so they cannot be challenged now. Dennis, 762 F.2d at 367. Moreover, the comment from the court during Mr. Rinehart's testimony, which was, "I'm tired of legal opinions from attorneys coming into this case improperly," Tr. at 493, related to Mr. Rinehart's testimony of what his own attorneys had told him about the subject of copyrightability. Mr. Rinehart's testimony had no relevance to what Mr. Chase's own attorneys had told Mr. Chase. Since Mr. Rinehart's knowledge of the copyright laws was not at issue, the legal opinion in question was undoubtedly improper.

suggested that defendants present the challenged evidence at the lunch break, Tr. at 443, but no offer was ever made.[9] Thus, it is difficult at this point to even assess the import of the ruling, since it is not clear exactly what the excluded testimony would have been. For example, it is unclear how detailed the opinions were, what types of forms they involved, or when the opinions were rendered.[10] Without an offer of proof, no new trial could be granted in any event.

The parties make a number of arguments about this evidence, citing cases involving specific types of advice from counsel, invoking the hearsay rule, and debating about the doctrine of invited error. The court finds it impossible to analyze these arguments without a clear understanding of exactly what the testimony would have been. That is the very reason for the offer of proof rule. Defendants cannot take advantage of the fact that they neglected to make the offer of proof by asserting that the evidence would have been in a form that would strengthen their weak arguments for a new trial.[11]

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[9] See supra note 7 and accompanying text.

[10] Defendants have represented to the court that the opinions were rendered in the 1970s. Defendants' Revised Memorandum in Support of a New Trial ("Defendants' Memorandum") at 26. Considering the changes that have occurred in the state of copyright law since then, it may not have been reasonable for Mr. Chase to rely on such old opinions. Again, without an offer of proof, it is impossible to tell.

[11] For example, defendants conveniently assert that Mr. Chase was going to recite a conversation between him and his attorney that would show his state of mind, Defendants' Reply at 19, and that he would have testified to specific reasoning as well as conclusions

(continued...)

Finally, even if the exclusion of this evidence were in error, any such error was harmless. The court specifically told defense counsel that Mr. Chase could testify as to his understanding of the copyright law, as long as he did not state his attorneys' legal conclusions. Tr. at 443. Mr. Chase did in fact testify at length as to his opinion on the copyrightability of the forms, relying on the Archie Phillips case.[12] The jury heard in detail about what Mr. Chase believed about the copyright law before this case occurred. The exclusion of some amorphous legal opinions from the 1970s was harmless error, if it was error at all, given the entire context of the case.

E. The Archie Phillips Case

Defendants next claim that they were prejudiced by the exclusion of testimony regarding the award of summary judgment in their favor in another copyright case. In fact, the "Archie Phillips" case, or "Alabama" case, was discussed at length. The Archie Phillips case was brought against Mr. Chase in Alabama for alleged copying of fish forms. The Alabama court ruled that the forms were not copyrightable because they were "useful articles." See Plaintiff's Exhibit 47 (Final Order and memorandum decision in Phillips v. Dan Chase Taxidermy Supply Co.). The court did not, however, allow Mr. Chase to interpret the Alabama ruling through his testimony. See Tr. at 444-46; 473. Again, the court was

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[11](...continued)
offered by counsel, Defendants' Reply at 16. Since neither of these allegations is clear from the record, see Tr. at 443-44, the court cannot consider them in deciding this motion.

[12] See Section E, infra.

cautious in not, wanting to confuse the jury about the copyrightability of the forms when that issue had already been decided. Tr. at 445 ("It doesn't matter what the judge ruled in terms of any law in this case.").[13]

There was no error in not allowing a lay witness to interpret a legal ruling given in a case, even when that witness was a party to the case. Mr. Chase was given substantial opportunity to explain what the case led him to believe; he simply was not allowed to tell the jury what the case meant objectively as a matter of law. Tr. at 444-46. By the end of the trial, every juror was surely familiar with the Archie Phillips case, its outcome, and its relevance. In fact, the final opinion in that case was an exhibit submitted to the jury. Plaintiff's Exhibit 47. Furthermore, defendants did not make an offer of proof as to any testimony of Mr. Chase which they felt was excluded. Fed. R. Evid. 103(a)(2). Since it is not clear what his legal interpretation of the ruling was (beyond his beliefs, which the court allowed into evidence), such an offer was required.

Defendants also argue that the court made comments which discounted the evidence about the Archie Phillips case. Not only did defendants not object to any of these comments, Dennis, 762 F.2d at 367, but the court cannot find any comment which discounted the case. Rather, the court's comments were designed to eliminate confusion about which

[13] In fact, when defense counsel explained that the purpose of her questioning was to ask about intent, the court allowed, "You can say as a result of that ruling he kept on doing it." Tr. at 445.

copyright case was being discussed. See Tr. at 596 ("Again, we're talking about the fish form case.").[14]

Finally, defendants' contention that exclusion of the evidence on interpretation of the Archie Phillips case somehow amounted to a "retroactive application of the copyright laws" is completely without merit. See Defendants' Memorandum at 41. Exclusion of evidence about previous legal rulings does not make the law retroactive. If defendants are attempting to suggest that this court's ruling on copyrightability was retroactive, they are again clearly wrong. Not only is this court not bound by a federal district court in Alabama, but the Archie Phillips case involved fish, not animal, forms. Defendants have not been subjected to any "retroactive application" of the law. No ruling of the court with regard to the Archie Phillips case was in error, and, thus, no new trial is warranted.

F. Jury Instruction on Willfulness

Defendants' next claim in support of their motion is that Jury Instruction number 34 was misleading to the jury. That instruction stated, "In general, evidence that notice had been accorded to the defendants before the specific acts found to have constituted infringement occurred is perhaps the most persuasive element of willfulness. It is not the only

[14] Likewise, defendants' allegation that the court encouraged plaintiff to present evidence of other lawsuits is ridiculous. Just as defendants were entitled to present evidence to show that defendants had no knowledge or intention to copy, plaintiff was entitled to show past violations to prove that defendants at least should have known the illegality of their actions. The court was quite clear on this ruling. It is ironic that one of defendants' examples of how the court "indulged" plaintiff is a situation in which the court twice sustained defendants' objections to plaintiff's questioning. Tr. at 244-45.

way that willfulness can be established." Tr. at 634. Defendants did make a timely objection to this instruction. Tr. at 540.

Instruction 34 is a correct statement of copyright law; the language was taken verbatim from a Seventh Circuit case, Video Views, Inc. v. Studio 21, Ltd., 925 F.2d 1010, 1021 (7th Cir.), cert. denied, 112 S. Ct. 181 (1991), with which this court is in agreement. The instruction merely informs the jury that in general the most persuasive evidence of willfulness is notice. It specifically notes that notice "is not the only way that willfulness can be established." Tr. at 634. Therefore, defendants' argument that notice was not the most persuasive element in this case, Defendants' Memorandum at 47, fails. That decision was for the jury, with the guidance of the instructions that properly informed them that, generally, notice was the most persuasive evidence on willfulness. It was for the jury to decide whether defendants had notice and what weight ultimately to give that evidence.

Defendants further argue that "Jury Instruction No. 34 was also prejudicial because of what it failed to include ...." Defendants' Memorandum at 47. Specifically, they allege that the instruction should have stated that reliance upon the advice of counsel or the Archie Phillips case[15] could negate a finding of willfulness. However, defendants never suggested such additions at the time they objected to this instruction. Tr. at 540. Defense counsel merely stated that

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[15] Again, the court does not agree with defendants' characterization of the Archie Phillips case as the "existing state of copyright laws" before this case. That case was in another jurisdiction and involved a different subject matter.

she did not think that notice "should be compelling evidence of willful infringement." Id. If defendants had submitted a proposed instruction covering advice of counsel or previous cases, the court would have considered it and either included or not included it, depending upon its validity. When defendants failed to give the court an opportunity to do so, they cannot now object to the court's failure to give an instruction which was never requested. Fed. R. Civ. P. 51. Instruction 34 does not entitle defendants to a new trial.

G. Comments of the Court

Defendants' final ground in support of their motion is a general objection to the conduct of the court during the trial.[16] Defendants allege that the court overstepped its bounds in commenting on the evidence and questioning the witnesses. Here again, defendants made no objection to any comments or questions by the court during the trial, as they were required by the rules of evidence to do. Fed. R. Evid. 614(c). Defendants do not even point to any specific comments of the court in this section of their memorandum; they merely allege that the court "interrupted the examination of the witnesses and experts repeatedly in circumstances which cannot have failed to affect the jury." No motion for a new trial can be granted on such a vague basis, especially when no objections were made.[17] Dennis, 762 F.2d at 367.

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[16] In addition to this general objection, defendants have throughout their brief made reference to specific comments of the court. The court finds none of its comments to be improper.

[17] Defendants claim that the comments of the court were plain error, and thus, no objections were required. See Rocha v. Great

(continued...)

Review of the transcript shows that there was no comment or question by the court which would have prejudiced the jury; thus, defendants have no basis for requesting a new trial on this ground. Parties are not entitled to uninterrupted examination of witnesses. Judges are permitted to interrogate witnesses which have been called by any party. Fed. R. Evid. 614(b). In fact, a trial judge "has an active responsibility to insure that issues are clearly presented to the jury. Thus, the questioning of witnesses by a trial judge, if for a proper purpose such as clarifying ambiguities, correcting misstatements, or obtaining information needed to make rulings, is well within that responsibility." United States v. Pisani, 773 F.2d 397, 403 (2d Cir. 1985). As a result of that responsibility, judges have wide discretion to interrogate all witnesses, including experts, and to comment on the evidence. Rocha, 850 F.2d at 1098. Of course, there are limits to this discretion. See Quercia v. United States, 289 U.S. 466 (1933) (holding that judge exceeded discretion, in criminal case, when he told jury that he believed that every word defendant said was a lie). In this case, though, those limits were never breached. Any comment made by the court was merely to clarify the testimony for the jury.

In any case, no harm came of the comments made by the court. Both before and after the evidence, the court instructed the jury that no comments made by it were to be taken as an indication of what the verdict should be. See Tr. at 27 ("You must not take anything I may say or do during the trial as indicating what your verdict should be."); Tr. at

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[17](...continued)
American Ins. Co., 850 F.2d 1095, 1098 (6th Cir. 1988). This court does not find plain error anywhere in the record of this case.

609-10 ("Do not assume that I hold any opinion on the matters to which my questions may have related. Remember at all times that you as jurors are at liberty to disregard all comments of the court ...."). In short, defendants cannot point to any question or comment by the court which deprived them of a fair trial. See Pisani, 773 F.2d at 402 (question is whether party received a fair trial, not whether trial was perfect).

III. Conclusion

Because defendants have made no showing of any error at trial which would require a new trial, defendants' motion for a new trial is DENIED.

The Clerk is DIRECTED to send a copy of this Memorandum Opinion to all counsel of record.

It is so ORDEED.

/s/Rebecca Beach Smith
UNITED STATES DISTRICT JUDGE

Norfolk, Virginia

August /s/5, 1994

APPENDIX I

UNITED STATES DISTRICT COURT
Eastern District of Virginia
Norfolk Division

JUDGMENT IN A CIVIL CASE

SUPERIOR FORM BUILDERS,

PLAINTIFF(S)

v. CASE NUMBER: 2:93cv940

DAN CHASE TAXIDERMY SUPPLY CO., INC., et al.,

DEFENDANTS(S)

X Jury Verdict. This action came before the Court for a trial by jury. The issues have been tried and the jury has rendered its verdict.

Decision by Court. This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

IT IS ORDERED AND ADJUDGED that the plaintiff Superior Form Builders recover of the defendants Dan Chase Taxidermy Supply Co., Inc. and Dan Chase the sum of Four Hundred Thousand Dollars and no/100 ($400,000.00), with interest thereon at the rate of 5.02% as provided by law, and his costs of action.

May 17, 1994 — *Date*

Doris R. Casey — *Clerk*

Form of judgment approved in accordance with Rule 58, FRCP, May 17, 1994

/s/ Rebecca Beach Smith
UNITED STATES DISTRICT JUDGE

/s/ Susan Cherry
(By) Deputy Clerk

APPENDIX J

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
Norfolk Division

SUPERIOR FORM BUILDERS,

Plaintiff,

v. ACTION NUMBER: 2:93cv940

DAN CHASE TAXIDERMY SUPPLY CO., INC., DAN CHASE,

Defendants.

MEMORANDUM OPINION

I. Facts and Procedural History

Plaintiff filed this suit alleging copyright infringement and unfair competition by defendants. Plaintiff has registered four copyrights with the United States Copyright Office for taxidermy forms or mannequins: two raccoons, a deer, and an otter. The forms are made through a multi-step process. First, the sculptor studies live animals. Then, he uses an animal carcass to make a plaster "death mask" for study purposes. He then sculpts an animal in a certain pose out of clay put over an armature. Next, the clay animal is made into a mold, which is used to create polyurethane

copies of the form. Plaintiff alleges that defendants, under the guise of a false name, ordered these four forms,[1] removed plaintiff's copyright notice, copied the forms, and placed their own copyright notice on the copies. Defendant Dan Chase admits that he "utilized" plaintiff's forms.[2] Defendants moved for summary judgment on the grounds that these forms are not properly copyrightable under the Copyright Act, and plaintiff responded. The court heard oral argument on the motion on April 12, 1994, and the motion is now ripe for decision.

II. Discussion of Law

The fact that plaintiff has received copyright registrations from the Copyright Office raises a presumption that the works are worthy of copyright protection. 17 U.S.C. § 410(c). Thus, the burden is on defendants to prove that plaintiff's copyrights are invalid. Masquerade Novelty v. Unique Industries, 912 F.2d 663 (3d Cir. 1990). These forms were registered under the section of the Act allowing copyright of "pictorial, graphic, and sculptural works." 17 U.S.C. § 102(a) (5). As defined in the Copyright Act, such works

> include two-dimensional and three-dimensional works of fine, graphic, and applied art, ... diagrams, and models. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or

---

[1]Plaintiff sells the polyurethane forms to taxidermists, who use them for mounting skins.

[2]See infra note 5.

> utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

Id. at S 101. Thus, the primary issue in this motion for summary judgment is whether the forms created by plaintiff are within this definition of pictorial, graphic, and sculptural works, namely whether the forms created by plaintiff are artistic or merely useful articles.[3]

Defendants argue that because the forms are used to mount animal skins, they are useful articles and can only be copyrighted if the artistic elements can be separated from their utilitarian elements. According to the Copyright Act, a useful article "is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the

---

[3]Plaintiff argues that this issue involves questions of fact and not of law. It relies on a Ninth Circuit case in which the court found that there was a question of fact as to whether a suit made out of clear plastic and crushed rock was meant to be used as a swimsuit, thus rendering it uncopyrightable, or merely to be viewed as art, which would allow the copyright. Poe v. Missing Persons, 745 F.2d 1238 (9th Cir. 1984). However, in the case at bar, there is no question as to the various things that are done with the forms -- they have been exhibited as art, painted, and covered with animal fur. Thus, there is no question of material fact as to this point and defendants' arguments on copyrightability are addressed herein as questions of law. See e.g., Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985) (issue of copyrightability appropriate for summary judgment).

article or to convey information." 17 U.S.C. § 101. In this case, the usefulness of the forms is their portrayal of the appearance of animals. Therefore, the forms by definition are not useful articles.

This reading of the statute is further supported by the case law. In the seminal case in the area of "useful articles," the Supreme Court held that statuettes that were used as table lamp bases were copyrightable. Mazer v. Stein, 347 U.S. 201, 214 (1954). The Court explained, "We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration." Id. at 218. The cases cited by defendants are inapposite. For example, defendants rely heavily on the Second Circuit case of Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985). In that case, the court concluded that mannequins of human torsos (without heads, legs, or arms) were not copyrightable "on the ground that [the mannequins] ... used to display articles of clothing are utilitarian articles not containing separable works of art ...." Id. at 412. However, in Barnhart, the plaintiff conceded that the mannequins were useful articles. Moreover, there is a conceptual difference between human mannequins used to display various articles of clothing on a temporary basis and animal forms that are used permanently to mount skins. The finished product in this case is unquestionably a permanent artistic object, while a generic, dressed human mannequin is a changeable advertisement.[4]

---

[4]Therefore, the issue of separability of usefulness and artistry is irrelevant here; unless the court decides that the article is useful, the question of separability never arises. See, e.a., Norris Industries v. Intern. Tel. & Tel. Corp., 696 F.2d 918 (11th Cir. 1983) (wire spoke wheel covers used as hubcaps to protect tire were not copyrightable

Cases from other courts also support a finding that these forms are artistic. For example, in Kamar Intern., Inc. v. Russ Berrie and Co., 657 F.2d 1059 (9th Cir. 1981), a case involving stuffed toys, the court held that realistic depictions of live animals are copyrightable, despite the fact that the idea comes from the public domain, as long as the depiction of the idea is original. Id. at 1061. Kamar was cited in Rachel v. Banana Republic, Inc., 831 F.2d 1503 (9th Cir. 1987), a case dealing with fiberglass animal forms from taxidermy supply stores which the plaintiff covered with flocking, paint, and eyes. The Ninth Circuit noted that "there is no dispute that [plaintiff's] works may be copyrighted. " Id. at 1507. Finally, the Third Circuit responded to an issue very similar to this one in Masquerade Novelty v. Unique Industries, 912 F.2d 663 (3d Cir. 1990). Masquerade Novelty involved animal nose masks. The defendant argued, and the district court found, that the masks had a utilitarian purpose in that they "allow(ed] a person to create humor by masquerading in an animal's nose." Id. at 664. The Third Circuit reversed, noting that almost any creation can be found to be a useful article if the definition is stretched far enough. Id. The court held that because the only utilitarian purpose of the masks was in the portrayal of animal noses, they did not meet the definition of "useful articles" and could be copyrighted. Id. In short, the forms in question in this case are not useful articles within the meaning of the Copyright Act because they likewise are only useful in their portrayal of the appearance of the animals.

---

because there were no separable artistic aspects); Keiselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 990 (2d Cir. 1980) (belt buckles with a sculptural design were copyrightable because the design could be separated from the function).

Defendants also argue that allowing plaintiff to copyright these forms would give it a "virtual monopoly" in the taxidermy supply business and would amount to allowing the copyright of an idea. This argument clearly fails. Copyright law does not protect ideas; it only protects the specific expression of those ideas. Mazer v. Stein, 347 U.S. 201, 217 (1954). In other words, plaintiff cannot prevent others from creating a raccoon or a deer "from scratch" from their own ideas in the same pose that plaintiff has used -- plaintiff can only prevent others from copying its forms. At trial, plaintiff will have the burden of proving that the similarities are not coincidental, but come from copying.[5] "Absent copying there can be no infringement of copyright." Id. at 218. No monopoly will be created by recognizing the validity of the copyrights in this case.

III. Conclusion

Defendants' motion for summary judgment is DENIED because the forms are not "useful articles" within the meaning of section 101 of the Copyright Act, but rather are properly copyrightable as sculptural works.

The Clerk is DIRECTED to send a copy of this Memorandum Opinion to all counsel of record.

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[5]However, defendant Chase has, in pretrial discovery, already admitted to "utilizing" plaintiff's forms to make the armatures used as the basis for the forms that defendants sold. Chase Dep. at 50, lines 6-16.

It is so ORDERED.

/s/ Rebecca Beach Smith
UNITED STATES DISTRICT JUDGE

Norfolk, Virginia

May /s/ 10 , 1994

(2)

No. 95-1765

Supreme Court, U.S.
FILED
MAY 24 1996
CLERK

IN THE

Supreme Court of the United States

October Term, 1995

DAN CHASE TAXIDERMY SUPPLY COMPANY, INC. and DAN CHASE,

Petitioners,

against

SUPERIOR FORM BUILDERS, INC.,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

BRIEF FOR AMICI CURIAE ARCHIE PHILLIPS, ET AL. IN OPPOSITION TO THE PETITION

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CONSENT OF THE PARTIES

Counsel of record for petitioners and respondents in this action have consented to the filing of this amici brief and their written consent is filed concurrently herewith.

QUESTIONS PRESENTED

Amici adopt the Questions Presented set forth in the petitions for Writ of Certiorari.

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STATUTES:

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OTHER AUTHORITY:

H.R. Rep. No. 1476, 94th Cong., 2d Sess. 54-55 (1976), reprinted in 1976 U.S. Code Cong. & Admin. News, pp. 5659, 5668 7

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ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

BRIEF FOR AMICI CURIAE ARCHIE PHILLIPS, ET AL. IN OPPOSITION TO THE PETITION

DESCRIPTION OF INTEREST OF AMICI CURIAE

Archie Phillips, Forest Hart, Sculptor, SCR Corporation d/b/a Jonas Supply Company, Rayline Mannikins, Inc., Research Mannikins, Foster Taxidermy Supply, Joe Coombs Classics, Inc., Jim Allred Taxidermy Supply, Matt Thompson Taxidermy & Supply, Martin Industries, and McKenzie Sports Products, Inc. (hereinafter "Suppliers") are sculptors, creators and/or owners of original three-dimensional works known in the taxidermy profession as "forms" or "mannikins". The Suppliers have placed copyright notices on their works and have registered their creations with the United States Copyright Office.

The Suppliers are not an organized group. They are independent companies, and are competitors of one another. The common interest the Suppliers share is to see their intellectual property rights protected. To prevent infringement upon these important rights, the Suppliers have attempted to curtail the activities of, among others, the Petitioners, Dan Chase Taxidermy Supply Company, Inc. and Dan Chase (hereinafter "Petitioners"). See *Hart v. Dan Chase Taxidermy Supply Company, Inc.*, 884 F.Supp. 71 (N.D.N.Y. 1995) In addition to other cases, the decision below sanctions those rights.

The Suppliers own or create original three-dimensional works that portray, in extreme detail, the body and form of various animal species. Through research, experience and imagination, the Suppliers (or their employees) create, in a clay medium, a sculpture of a particular animal, with an original pose, attitude and aspect. Although anatomically accurate, it is the sculptor's individual style and expression that translates his or her idea into a tangible medium.

The Suppliers primarily offer their works for sale through catalogs. There are hundreds, if not thousands, of different mannikins offered for sale; even for a particular species such as the whitetail deer. The Suppliers recognize the rights of others to create their own version of such mannikins, including, for example, a whitetail deer mannikin, from scratch[1]. However, they do not condone copying of theirs or others' original works.

The National Taxidermists Association (hereinafter "NTA") is a not-for-profit organization comprised of many of the nation's professional taxidermists and related professionals. The NTA, in addition to various administrative and fiscal functions, offers guidance to its members. Part of that guidance takes the form of a Code of Ethics.

Cannon Eleven of the NTA Code reads:

> I will not cast or reproduce any form or part thereof except my own, sculpted by me or my employee(s), unless I have specific permission to do so from the originator of the form.

The NTA seeks compliance with its Code of Ethics. The NTA's Code of Ethics, and particularly Cannon Eleven, was referred to in the decision below.

---

[1] Most of the Suppliers offer for sale mannikins they have each created for the same species of animal, such as a whitetail deer.

If the decision below is left undisturbed, the intellectual property rights of the Suppliers will remain undisturbed, and the NTA's Code of Ethics will be recognized. This result is in the best interests of copyright owners, taxidermists and the public. If anyone was allowed to copy the works sculpted by another, there would be no incentive to create new works.

STATEMENT OF THE CASE

Amici adopt the Statement of the Case set forth in Petition for Writ of Certiorari, as well as Petitioner's description of the Opinions Below, Statement of Jurisdiction and Statutes involved.

REASONS FOR DENYING THE WRIT

By its decision, the court below recognized the copyrightability of original three-dimensional works known as taxidermy forms. Finally, taxidermists and other taxidermy professionals had confirmation of their custom and practice of respecting the copyrights of the forms' sculptors; a practice reflected in the NTA Code of Ethics.

As set forth in the following pages, this Court's consideration of the questions presented by the Petitioner is inappropriate because:

(1) there is no conflict between the decision below and a decision of another United States court of appeals; and

(2) the decision below correctly interprets the Copyright Act.

I.
THE DECISION BELOW IS NOT IN CONFLICT WITH A DECISION OF ANOTHER UNITED STATES COURT OF APPEALS OR THE COPYRIGHT ACT.

The question raised by Petitioner is whether taxidermy mannikins are copyrightable within the meaning of the Copyright Act. See 17 U.S.C. § 101. The court below properly

decided this issue, and there is no conflict with either the legislative history of the Copyright Act or another United States court of appeals.

A. The Court of Appeals' Decision Accords with other Court of Appeals Decisions.

Contrary to Petitioners' argument, no other United States circuit has conflicting case law on the specific issue decided below. The circuits that have addressed the copyrightability of taxidermy mannikins or realistic depictions of animals are the First, Second, Third and Ninth Circuits. See *Concrete Machinery Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 607 (1st Cir. 1988)(concrete lawn ornaments - deer); *Hart v. Dan Chase Taxidermy Supply Company, Inc.*, 884 F.Supp. 71 (N.D.N.Y. 1995)(taxidermy mannikins)[2]; *Masquerade Novelty, Inc. v. Unique Industries, Inc.*, 912 F.2d 663, 671 (3d Cir. 1990)(animal nose masks); *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503, 1507 (9th Cir. 1987)(taxidermy mannikins); *Kamar International, Inc. v. Russ Berrie and Co.*, 657 F.2d 1059, 1061 (9th Cir. 1981)(realistic depictions of animals). The cases consistently hold that the subject matter is copyrightable.

Under the reasoning proffered by Petitioners, any painting that realistically depicted an animal, such as the works of John J. Audubon, would not be protectable under the Copyright Act. Significantly, the Act does not foreclose such.

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[2] This case was appealed to the Second Circuit Court of Appeals by Archie Phillips, Jim Allred Taxidermy Supply, and Matt Thompson Taxidermy and Supply, on the subject of the copyrightability of fish mannikins. The appeal was argued on March 21, 1996. The Court of Appeals has not yet rendered a decision.

B. The Court of Appeals Decision Accords with the Intent of the Copyright Act.

The Copyright Act, and the "useful article" language currently set forth at section 101, is merely a codification of this Court's decision in *Mazer v. Stein*, 347 U.S. 201 (1954). See H.R. Rep. No. 1476, 94th Cong., 2d Sess. 54-55 (1976), *reprinted in* 1976 U.S. Code Cong. & Admin. News, pp. 5659, 5668. In *Mazer*, this Court was faced with the issue of whether a lamp base that incorporated sculptured figurines was copyrightable. *Id.* In reaching its decision, the *Mazer* Court examined the question of utilitarian use of copyrighted articles. *Id* at 208. Ultimately, this Court held:

> We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration. We do not read such a limitation into the copyright law.

Id at 218.

Petitioner takes a position counter to *Mazer* and the Copyright Act. There is no dispute that Respondent's and Suppliers' works are three-dimensional sculptures. Furthermore, the sculptures, which are done in extreme detail, would be copy-

rightable if they did not perform their purported "function" as a base to hang skins upon[3]. Just as the petitioner in *Mazer* argued that the figurines lost their copyrightable status when they became a base for a lamp, Petitioner herein urges the mannikins should lose their status as sculptures because a taxidermist hangs skins on them. Such reasoning is flawed.

Petitioners' argument that a monopoly has been created is similarly misplaced. It is axiomatic that the Suppliers, all competitors with each other, and who create and offer for sale taxidermy mannikins for the same species, are not monopolizing the idea. It is not the species, the pose, or the attitude that Suppliers seek protection of, it is their individual style that separates one's version of a species, such as whitetail deer, from another's. See *Concrete Machinery Co.*, 843 F.2d 600, 607. Such a position is consistent with the underpinnings of the Copyright Act and the decision below.

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[3] This Court in *Mazer* noted, "[i]ndividual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art. ... Such expression, whether meticulously delineating the model or mental image or conveying meaning by modernistic form or color, is copyrightable. ..." *Id* at 214.

CONCLUSION

For the foregoing reasons, and those articulated in Respondent's brief, we urge the Court to deny the Petition for Writ of Certiorari.

Dated: May 21, 1996

Respectfully submitted,

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In The

Supreme Court of the United States

October Term, 1995

DAN CHASE TAXIDERMY SUPPLY CO., INC., *et al.*,

Petitioners,

vs.

SUPERIOR FORM BUILDERS, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court Appeals for the Fourth Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

Respondent adopts the Questions Presented set forth in the Petition for Writ of Certiorari.

STATEMENT PURSUANT TO RULE 29.6

Superior Form Builders, Inc. has no parent companies or nonwholly owned subsidiaries.

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APPENDIX

Appendix A — Order of the United States Court of Appeals for the Fourth Circuit Filed February 20, 1996 ..... 1a

Appendix B — Order of the United States Court of Appeals for the Fourth Circuit Filed April 23, 1996 ..... 3a

CORRECTION OF MISSTATEMENTS IN OPINIONS BELOW

The Petitioner ("Chase") mistakenly sets out in its Appendix (Pet. App. 42a) the original decision of Judge Smith which contains a typographical error. The last sentence of the second paragraph on Pet. App. 45a reads "In short, considerations of compensation and deterrence *do not* justify an award of attorneys' fees in this case." By letter of September 19, 1994, Judge Smith sent to Counsel a re-typed page 4 of her Opinion and asked that it be substituted for the original page 4. The substituted version states: "In short, considerations of compensation and deterrence *justify* an award of attorneys' fees in this case." The parties then filed a joint stipulation with the Court of Appeals pursuant to Rule 10(e) correcting the Appendix in that regard. The reported decision granting Respondent's ("Superior") petition for award of attorney's fees sets forth the corrected version of the District Court's opinion. *Superior Form Builders v. Dan Chase Taxidermy Supply Co., Inc.*, 881 F. Supp. 1021, 1025 (E.D. Va. 1994), *aff'd*, 74 F.3d 488 (4th Cir. 1996).

STATEMENT OF THE CASE

The Respondent adopts the Statement of Jurisdiction and the description of the statutes involved in the Petition for Writ of Certiorari.

On September 14, 1993, Superior Form Builders ("Superior") filed a Complaint alleging that Dan Chase Taxidermy Supply Company, Inc. and Dan Chase (collectively "Chase") infringed on four taxidermy forms that had been registered pursuant to the copyright laws. Superior sought equitable relief, statutory damages and attorneys' fees and costs. On March 25, 1994, Chase moved for summary judgment on the grounds that the forms were not copyrightable. Superior

opposed the motion and on May 10, 1994, the District Court properly denied Chase's motion for summary judgment and entered summary judgment for Superior on the issue of copyrightability.

A jury trial was held in the United States District Court beginning on May 12, 1994 and ending on May 17, 1994. Pursuant to a special verdict form, the jury returned a verdict finding that Chase willfully infringed on all four forms at issue. The jury awarded the maximum statutory damages of $100,000 on each form for a total of $400,000.

The District Court entered a Temporary Restraining Order against Chase on May 17, 1994 and judgment on the jury verdict was entered on the same day. An order extending the Temporary Restraining Order was entered on May 26, 1994.

On June 1, 1994, Chase filed a motion for a new trial which was denied by the court in a Memorandum and Opinion Order dated August 5, 1994. On September 2, 1994, Chase filed a notice of appeal. On September 16, 1994, the District Court entered a judgment against Chase for costs and attorneys' fees in the amount of $74,104.50, pursuant to a Memorandum Opinion and Order. On September 23, 1994, the District Court entered an order granting Superior Form Builders permanent injunctive relief. On September 23, 1994, Chase filed an Amended Notice of Appeal covering all of the orders and judgments of the District Court.

On Appeal, the United States Court of Appeals for the Fourth Circuit affirmed the District Court's decision in its entirety. Chase filed a motion for stay of the mandate and the Court of Appeals denied that motion. (Resp. App. 1a). Chase then filed a motion for reconsideration and for recall of the mandate. Again the Court of Appeals denied the motion for reconsideration and for recall of the mandate. (Resp. App. 3a).

STATEMENT OF FACTS

Superior Form Builders, through its owner and president, Tommy Knight, is in the business of creating and marketing taxidermy forms which are used for the mounting of animal skins. As of the date of trial, the company had been in existence for approximately three (3) years. The creation of the mannequins is a painstaking and time consuming process that involves both field research of animals in their natural habitat and sculpting skills on the part of Mr. Knight. The mannequins at issue are the original creations of Mr. Knight and the copyrights are assigned to his company Superior Form Builders. The poses and attitudes of the mannequins in question are the original products of Mr. Knight's research and artistic skill.

Superior's president, Tommy Knight, only has an eighth grade education but he creates these forms using traditional sculpturing techniques. Using a carcass cast as a model, Knight makes an armature on which to hold clay and then molds out of the clay a sculptured model of the desired animal with precise anatomical features. A mold is then made of the sculpture and forms of the sculpture are then reproduced in polyurethene.

The unadorned sculptures made by Knight have been entered into art contests. One of the forms, which is the subject matter of this suit — the deer form — won Honorable Mention in an art contest in Wakefield in the sculpture division. Other sculptures have won awards in other contests.

The four sculptures which are the subject matter of this suit all have been registered with the copyright office and have been awarded copyrights. All of the forms are legibly stamped with the copyright insignia and inform purchasers that the forms are copyrighted.

Dan Chase ordered the four forms at issue from Superior using a false name to mislead Superior as to who was actually purchasing its products. Chase then took the mannequins, copied them, placed them in his catalog for sale, removed Superior's notice of copyright and affixed a false copyright notice of his own.

Dan Chase, is the president and chief executive officer of Dan Chase Taxidermy Supply Company, Inc. (Dan Chase Taxidermy). From an educational standpoint, Mr. Chase is close to obtaining his Ph.D. Unlike Superior, which only offered for sale approximately eleven forms in 1991-92, Dan Chase Taxidermy bills itself as the largest taxidermy supply company in the world. By Mr. Chase's estimate, he offers over 3,000 forms for sale. He has been in the business twenty-seven years and he considers himself a millionaire. Mr. Chase's company had sales of approximately $2,750,000 in 1991 and $2,718,000 in 1992.

The four forms in question were displayed in Superior's first catalogue, the 1991-92 edition. This catalog came out in December 1991. In January of 1992, the plaintiff received an order from Tolbert's Taxidermy, Route 3, Box 72B, Jonesville, LA. The order was for the four forms which are the subject matter of this litigation. Superior sent the forms C.O.D. to Tolberts. In reality, there is no Tolbert's Taxidermy. Route 3, Box 72B, Jonesville, LA is the home of Dan Chase and Lilly Chase. As admitted by Dan Chase, one of his employees, Joyce Spinks, signed a UPS slip for the receipt of the forms sent by Superior Forms to Tolbert's Taxidermy.

Chase admitted that he directed his employees to order the forms in Tolbert's name because if he had used his real name, he doubted individuals, such as Knight, would send the forms to him. Chase further admitted that he has directed employees to

order forms from other companies under fictitious names. In fact, even after the present litigation commenced, Chase had his sister Martha Moss, who lives 140 miles from him, order three other forms from Superior.

Prior to ordering the forms which are the subject matter of this dispute, Chase admitted that he did not offer in his catalogues similar forms to the ones ordered from Superior. In point of fact, these forms do not appear in the 1991-92 Dan Chase Taxidermy Supply Company catalogue or previous catalogues. The Chase 1992-93 catalogue, however, was printed in October of 1992, approximately ten months after Chase ordered the forms from Superior. Substantially identical forms to the Superior's forms are offered in the 1992-93 and subsequent catalogues.

At trial and in his brief, Chase admitted that he "utilized" the forms purchased from the plaintiff in making molds that he sells to the public. In the opinion of Tom Knight and his expert, Ralph Garland, the forms sold by Chase are substantially similar, and in some cases almost identical, to the forms sold by plaintiff. In fact, Mr. Knight demonstrated to the jury by way of measurement and comparison the extent of the similarities.

Although Chase takes the position that Superior's forms are not subject to copyright, Chase had no hesitation in placing his own copyright sign on the forms that he copied from Superior. All of the Dan Chase forms which are alleged to be copies of Superior's copyrighted forms, bear the name Dan Chase, with a copyright insignia and the date of the alleged copyright. Moreover, all of Dan Chase's catalogues state on the order information page that "each mannequin in this catalogue is legally copyrighted according to the law of the United States of America and any infringement will be vigorously prosecuted".

Chase admitted that his intent in warning purchasers that his forms are copyrighted was to "bluff" people into thinking his forms are copyrighted. He further admitted and stipulated in the pretrial order that none of his forms are copyrighted according to the laws of the United States.

Ironically, despite his protest that it is not illegal to copy Superior's forms, Chase takes the moral "high-road" in warning his purchasers of "copycats". As noted in one of his catalogues, Chase warns purchasers to:

"BEWARE OF LOOK-A-LIKES!"

> Practically everyone recognizes the fact we are being copied by the desperate "copy cats" working overtime in an attempt to deceive the public and violate the rights of others.

Chase and his company are no strangers to the world of copyright infringement. In 1989, Chase and his company were sued by Sportsmen On Film, Inc. for copyright infringement. That suit alleged that Chase purchased copyrighted tapes from Sportsmen On Film, Inc., erased the name, substituted the name of Dan Chase and falsely packaged and labeled the videos with the copyright notice indicating that Dan Chase was the owner of the copyright of those tapes. Chase admitted that this was done. According to him, the company made an innocent mistake and neither he nor his company really contested the lawsuit and eventually settled it.

In 1987, Chase also was sued by Jonas Brothers, a taxidermy supply company, for copyright infringement. Chase settled that case. He has also been accused by at least three other people in the industry — Joe Kish, Ivan Harvey and Dennis Middleton — of illegally copying their forms. He was also sued in the United

States District Court for the Northern District of New York by eleven (11) plaintiffs who alleged almost the exact same thing that Superior alleges against the defendants, that is, copyright infringement of taxidermy forms.

Chase incorrectly states in his Statement of Facts that "it is undisputed that Chase did not copy the surface features of SFB's mannequins." At trial of this matter, Superior's President Knight and Superior's expert compared Chase's mannequins with Superior's mannequins. The jury had the opportunity to view physical dimensions, width, length, size, shape, etc. In some instances the mannequins were almost identical and the surface features were the same.

REASONS FOR DENYING THE WRIT

I.

THE DISTRICT COURT AND APPEALS COURT WERE CORRECT IN HOLDING THAT THE TAXIDERMY MANNEQUINS WERE NOT USEFUL ARTICLES.

In the case at hand, Superior's experts and witnesses testified the animal forms are displayed as pieces of art and are shown, without skins, in art museums and museums of natural history. There is no question that the forms are also used in the taxidermy profession for purposes of mounting animal skins. Moreover, there is no question that the final mounted animal is copyrightable. *Kamar Int'l, Inc. v. Russ Berrie and Co.*, 657 F.2d 1059 (9th Cir. 1981); *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503 (9th Cir. 1987). In fact, Chase admitted in argument before the trial court that the final mounted animal is a piece of art.

The mounted animal has no function other than to portray

the appearance of the animal. It is either hung on the wall or stood in the corner. Likewise, the sculptured forms serve no purpose other than to portray the appearance of the animal. Taxidermists buy these forms because of the way they look and because of their realism and accuracy.

One of Superior's experts, Dennis McElvain, stated that taxidermists are attracted by the "artistic impression of that animal" when they purchase a form. If the taxidermist likes the "position" or if he likes "what the artist has created in terms of his knowledge of anatomy and position," then he will "purchase that".

In *Masquerade Novelty v. Unique Indus.*, 912 F.2d 663 (3rd Cir. 1990), the court addressed the issue of the copyrightability of animal nose masks. The defendant argued, as does Chase, that the mask had a utilitarian purpose in that they "allowed a person to create humor by masquerading in an animal's nose." *Id.* at 664.

The Third Circuit reversed, noting that almost any creation can be found to be a useful article if the definition is stretched far enough. *Id.* The court went on to hold that the masks were not useful articles because they had no utility that did not derive from their appearance.

Chase focuses on the fact that the mannequins serve the mechanical function of supporting an animal skin and facilitating the taxidermy mounting process. Chase argues that the District Court and Court of Appeals ignored the mannequins inherent utilitarian purpose and focused on the nature of the finished product.

A work of art that has been afforded copyright protection is not deprived of its protected status merely because it is substantively put to functional use. *Mazer v. Stein*, 347 U.S. 201,

74 S. Ct. 460, 98 L. Ed. 630 (1954). As the Court of Appeals correctly stated:

> In this case, Chase argues that Superior Form's animal mannequins have the utilitarian function of acting as mounts for animal skins for display. But this argument overlooks that which distinguishes mannequins from ordinary plastic foam pellet animal stuffing: A mannequin provides the creative form and expression of the ultimate animal display, whereas pellets do not. Even though covered with a skin, the mannequin is not invisible but conspicuous in the final display. The angle of the animal's head, the juxtaposition of its body parts, and the shape of the body parts in the final display is little more than the portrayal of the underlying mannequin. Indeed, the mannequin can even portray the intensity of flexed body parts, or it can reveal the grace of relaxed ones. None of these expressive aspects of a mannequin is lost by covering the mannequin with a skin. Thus, any utilitarian aspect of the mannequin exists "merely to portray the appearance" of the animal.

See 17 U.S.C. § 101. 74 F.3d 488, 493-94. (Pet. App. 24a).

II.

THE APPEALS COURT DID NOT FAIL TO CONDUCT A SEPARABILITY ANALYSIS.

Chase incorrectly states that the Court of Appeals "failed to conduct a separability analysis and thus concluded that taxidermy mannequins used for the mounting of animal skins are copyrightable." Relying on the Second Circuit's separability analysis in *Brandir Int'l Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142 (2nd Cir. 1987) and *Kieselstein-Cord v. Accessories By Pearl, Inc.*, 632 F.2d 989 (2nd Cir. 1980), the Court of Appeals specifically held that to the extent that an argument can be made that the mannequins performed a utilitarian function by supporting the mounted skins "we believe the function to be conceptually separable from the work sculptural features." 74 F.3d at 494. (Pet. App. 25a).

III.

THE COURT OF APPEALS DECISION DOES NOT CREATE A SPLIT AMONG THE CIRCUITS IN THE INTERPRETATION AND APPLICABILITY OF THE COPYRIGHT ACT.

Chase argues that the Fourth Circuit rejects the reasoning annunciated by the Second Circuit in *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2nd Cir. 1985). Accordingly, Chase argues that a split exists among the Circuits which requires review by this Court.

The *Barnhart* case is distinguishable from the present case in several important factual areas. First, it was conceded in *Barnhart* by all of the parties that the mannequins were useful articles. *Id.* at 414. Moreover, there was no question that the

mannequins were used to display clothing and that clothing has universally been held to be a useful article not subject to copyright. *Whimsicality, Inc. v. Rubie's Costume Co., Inc.*, 891 F.2d 452, 455 (2nd Cir. 1989).

Unlike the situation in *Barnhart*, where neither the mannequins nor the clothing were found to be copyrightable, there is no question the final mounted animal is copyrightable. *Kamar Int'l Inc., supra; Rachel v. Banana Republic Inc., supra.* In fact, as noted above, Chase stipulated that the final mounted animal is a copyrightable piece of art.

In *Barnhart*, the court was faced with headless, limbless, human torsos made of styrene that were used to display clothes. The torsos were not anatomically correct in that they had hollow back designed to hold excess fabric. The court held that the styrene torsos were mainly designed to display clothes and had no aesthetic features that were separate from that utilitarian function.

Discussing *Barnhart*, the District Court below correctly stated that there is a "conceptual difference between human mannequins used to display various articles of clothing on a temporary basis and animal forms that are used permanently to mount skins. The finished product in this case is unquestionably a permanent artistic object, while a generic, dressed human mannequin is a changeable advertisement." 851 F. Supp. at 224. (Pet. App. 87a).

The Court of Appeals also noted that *Barnhart* was distinguishable in significant respects. The only indication that the Court of Appeals disagreed with *Carol Barnhart* was couched in the following hypothetical situation:

> While we believe that *Carol Barnhart* is thus

> distinguishable in significant respects, to the extent that it might be construed as leaving unprotected an author's mode of expression fixed in a tangible medium for the purpose of betraying that expression, we would disagree with its holding.

74 F.3d at 494. (Pet. App. 26a).

In summary, for Chase to argue that there "is no meaningful or principal manner in which these two decisions may be distinguished or reconciled" begs the question. The *Barnhart* decision is clearly distinguishable from the case at hand. Accordingly, no conflict exists.

IV.

THE MERGER DOCTRINE WAS ADEQUATELY HANDLED BY CHASE'S OWN INSTRUCTION ON THE ISSUE.

Chase argues that the merger doctrine bars copyright protection for taxidermy mannequins in the instant case and further states that the Fourth Circuit has granted Superior a monopoly of the idea of its animal mannequins "free from the conditions and limitations imposed by applicable law." *Citing Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971), Chase argues that the Fourth Circuit failed to make the critical distinction between "idea and expression" thereby allowing Superior to have a virtual monopoly of the idea of its animal mannequins.

Chase adequately addressed the merger doctrine at trial by offering an instruction to the jury which gave the jury the opportunity to find for Chase on the issue of merging an idea and its expression:

> When reproduction of a life-like object is at issue, the plaintiff must prove substantial similarity to those aspects of the work that are an expression not required by the idea. In determining substantial similarity, to the extent that works are similar in ideas and general concepts, the similarities are non-infringing. Furthermore, even similarities and expression are non-infringing when the nature of a creation makes sub-similarities necessary. Such indispensable expression of ideas may be protected only against virtually identical copying.

Accordingly, the jury had full opportunity to make visual comparisons of the mannequins to determine if there was virtually identical copying. In addition to expressions, the evidence presented to the jury also had to do with physical dimensions, width, length, size, shape, etc. This was more than mere expression. This entailed comparing physical dimensions of Chase's and Superior's forms which in some instances were identical.

In the face of uncontradicted evidence that Chase attempted to monopolize the forms he sold — by falsely warning suppliers, taxidermists and customers that his forms were copyrighted — Chase now argues to this Court that public policy requires a finding that Superior's taxidermy forms are not copyrightable.

The District Court below resolved this issue by stating:

> Defendants also argue that allowing plaintiff to copyright these forms would give it a " 'virtual monopoly' in the taxidermy supply business and would amount to allowing the

copyright of an idea." This argument clearly fails. Copyright law does not protect ideas; it only protects the specific expression of those ideas (citations omitted). In other words, plaintiff cannot prevent others from creating a raccoon or a deer "from scratch" from their own ideas in the same pose plaintiff has used — plaintiff can only prevent others from copying its forms. At trial, plaintiff will have the burden of proving that the similarities are not coincidental, but come from copying. "Absent copying there can be no infringement of copyright." (citations omitted). No monopoly will be created by recognizing the validity of copyrights in this case.

851 F. Supp. at 224. (Pet. App. 89a).

If Chase's arguments on monopoly were valid, no one could copyright a statute or any other piece of art displayed in any medium. The idea of a leaping deer is not copyrightable but a sculpture of that deer certainly is.

Superior does not contend that some other sculptor cannot create a form of a raccoon, deer, etc. Wildlife has been the subject of artistic expression for countless years and will no doubt continue to do so. The copyright law and public policy, however, protects honest persons who want to express themselves artistically, regardless of subject matter. The law only restrains those who willfully copy and profit from the work and talent of others.

V.

THE COURT OF APPEALS PROPERLY RULED THAT THE DISTRICT COURT DID NOT ABUSE ITS DISCRETION IN AWARDING ATTORNEYS' FEES.

Chase does not question the reasonableness of the attorneys' fees awarded by the District Court but submits that the Court of Appeals erred in not finding that the District Court abused is discretion in awarding attorneys' fees. The Court of Appeals noted Chase's history and the inconsistent positions that he has taken over the years. At the same time that he contended that animal mannequins are not copyrightable, Chase falsely affixed his own copyright notices to copied mannequins and warned others that his mannequins were legally copyrighted and "any infringement would be vigorously prosecuted." Given his wholesale disregard of the copyright laws and his troubled past with copyright litigation, the District Court concluded that Chase's conduct was "outrageous" and that considerations of "compensation and deterrence justify an award of attorneys' fees" in this instance. The Court of Appeals concluded that the District Court's finding was amply supported. Accordingly, the Appeals Court was correct in holding that the record supported the District Court's decision to award attorneys' fees and costs.

CONCLUSION

The Respondent respectfully submits that this case presents no issue of law or fact that justifies review by the United States Supreme Court. The Petitioner has had this record properly reviewed both at trial court and the appellate court levels. The Respondent respectfully submits that the decisions of these courts are proper and the Petition for Writ of Certiorari should be denied.

Respectfully Submitted,

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APPENDIX A — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT FILED FEBRUARY 20, 1996

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 94-2139
(CA-93-940-N)

SUPERIOR FORM BUILDERS,

Plaintiff - Appellee,

versus

DAN CHASE TAXIDERMY SUPPLY COMPANY, INCORPORATED; DAN CHASE,

Defendants - Appellants,

and

LILLY CHASE,

Defendant.

ORDER

Appellants have filed a motion for stay of mandate pending application to the United States Supreme Court for writ of certiorari.

The Court denies the motion for stay of mandate.

Appendix A

For the Court - By Direction

/s/ Bert M. Montague
Clerk

APPENDIX B — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT FILED APRIL 23, 1996

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 94-2139
CA-93-940-N

SUPERIOR FORM BUILDERS

Plaintiff - Appellee

v.

DAN CHASE TAXIDERMY SUPPLY COMPANY, INCORPORATED; DAN CHASE

Defendants - Appellants

and

LILLY CHASE

Defendant

ORDER

Appellant has filed a motion for reconsideration of the denial of its motion to stay the mandate and for recall of the mandate and the appellee has filed a response in opposition.

The Court denies the motion for reconsideration and for recall of the mandate.

Appendix B

For the Court

/s/ Bert M. Montague
CLERK

Supreme Court, U.S.
FILED
JUL 3 1996
CLERK

No. 95-1765

In The Supreme Court Of The United States

OCTOBER TERM 1995

DAN CHASE TAXIDERMY SUPPLY COMPANY, INC. and DAN CHASE,

Petitioners,

V.

SUPERIOR FORM BUILDERS, INC.,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

---

REPLY TO BRIEF IN OPPOSITION

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No. 95-1765

IN THE
SUPREME COURT OF THE UNITED STATES
October Term, 1995

DAN CHASE TAXIDERMY SUPPLY COMPANY, INC.
and DAN CHASE,

Petitioners,

v.

SUPERIOR FORM BUILDERS, INC.,

Respondents.

REPLY BRIEF OF PETITIONERS

INTRODUCTION

Notning could better illustrate the immediacy of the issues presented here than two opinions handed down on these same questions by two Circuit Courts of Appeals while this case was being briefed. The continuing development of the law in divergent directions in the different circuits on the issues of the copyrightability of useful articles and the merger of idea and expression underscores the need for this Court to grant the petition here.

On March 5, 1996, the United States Court of Appeals for the Tenth Circuit decided the case of *Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280 (10th Cir. 1996), holding that the basic and utilitarian aspects of a wooden doll could not be copyrighted. *Id.* at 1287.

On June 26, 1996, the United States Court of Appeals for the Second Circuit decided the case of *Hart v. Dan Chase Taxidermy Supply Co., Inc.*, --- F.3d ---, 1996 WL 346330 (2d Cir., June 26, 1996),[1] vacating the judgment below and remanding the case because the district court failed to conduct an analysis of the merger of idea and expression. --- F.3d at ---, 1996 WL 346330, at *3. Appellees in *Hart*, like Petitioners here, cited the earlier case of *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985), relating to department store mannequins, as authority that taxidermy mannequins were not copyrightable due to the merger of idea and expression. The opinion in *Hart* rejected this reading of *Carol Barnhart*, and held, contrary to the opinion below in this case, that ordinary taxidermy mannequins are copyrightable. Thus, the decision resolved an apparent conflict, but in doing so raised another, sharper conflict between the circuits on the question of copyrightability.

Both *Country Kids* and *Hart* emphasize the critical nature of the analysis of the merger of idea and expression to correct application of copyright law. The court in *Country Kids* adapted the "abstraction-filtration-comparison" test developed for use in the context of alleged infringement of computer software. 77 F.3d at 1284. The court in *Hart* remanded the case with a detailed instructions on the procedure that the district court should follow in conducting its analysis. --- F.3d at ---, 1996 WL 346330 at *3. The contrasting methodologies, particularly the failure of the court below to conduct meaningful analysis, points to another issue calling for the attention of the Court in this important area of federal law.

Respondent and amicus argue that there is no conflict among the circuits in the application of the Copyright Act and that the law was correctly applied by the court below . These cases demonstrate that these arguments cannot be maintained.

---

[1]A copy of this opinion is being lodged with the Clerk for the convenience of the Court until its publication.

ARGUMENT

I. The Failure of the Court Below to Analyze Respondent's Mannequins to Separate Non-Protectable Ideas From Copyrightable Expression Misapplied the Law and Disregarded Established Practice in Other Circuits.

Petitioners contend that a separability analysis, that is, an analysis of the product in question to distinguish those portions which are inherent and inseparable from the idea from the elements, if any, which are protectable by copyright, is a fundamental and necessary step in the correct application of the law. The failure of the court below to conduct such an inquiry stands in stark contrast to the importance placed on this step by other circuits applying the Copyright Act.

The *Hart* case involved taxidermy mannequins for mounting fish. The court recognized that mannequins straddle the line between utilitarian and sculptural works. --- F.3d at ---, 1996 WL 346330 at *2. The court held that the trial court's failure to conduct an analysis of the merger or separability of idea and expression was reversible error. *Id.* at *3. The court explained the principle as follows:

> The fundamental copyright principle that only the expression of an idea and not the idea itself is protectable has produced a corollary maxim that even expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself.

--- F.3d at ---, 1996 WL 346330 at *2.

Essentially, the merger inquiry asks whether all taxidermy mannequins, no matter how artistic they might be, will necessarily be "substantially similar". If this is so, there

is no unique expression to protect under the copyright laws. 1996 WL 346330 at *2. Copyright litigation typically involves two inquiries: whether there is a valid copyright, and if so, whether it has been infringed. *See Country Kids*, 77 F.3d at 1284. Although the concept of merger of idea and expression and thus the necessity for conducting separability analysis arises in the context of copyrightability, the *Hart* court indicated its strong preference for considering the issue whether an idea inevitably merges with its expression in the context of the infringement inquiry. --- F.3d at ---, 1996 WL 346330 at *2.

Similarly, the court in *Country Kids* found it useful to apply the "abstraction-filtration-comparison" test. 77 F.3d at 1284-85. At the abstraction step, the court separates the ideas and basic utilitarian functions which are not protectable from the particular expression of the work. Then the court filters out the non-protectable components of the product from the original expression. Finally, the court compares the remaining protective elements to the allegedly copied work to determine if the two works or substantially similar. *Id.* Thus, the test involves a similar blending of the copyrightability and infringement inquiries as in *Hart*.

As another court has noted, in a realistic portrayal of a deer, most of the features are supplied by the deer. *Concrete Machinery Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 607 (1st Cir. 1988). A separability analysis is mandated to determine if there are protectable elements in the work. *Id.* at 608. The *Concrete Machinery Co.* court called the process "dissection". *Id.*

Respondent argues that the court below did in fact conduct a separability analysis. Respondent relies on the statement in the opinion that the court "believed" the function of the mannequins to be conceptually separable from the works' sculptured features. *See* Pet. App. 25(a); *Superior Form Builders v. Dan Chase Taxidermy Supply Co., Inc.*, 74 F.3d 488, 494 (4th Cir. 1996). This hardly rises to the level of rigor expected by the courts in *Hart*, *Country Kids*, or *Concrete Machinery Co.*

Respondent next argues that the issue of separability in this case was adequately addressed by a jury instruction. Respondent's Brief in Opposition at 12-13. But separability, whether the idea and expression merge so as to preclude copyrightability, is a question of law for the court. *Hart*, --- F.3d at ---, 1996 WL 346330 at *3; *Country Kids*, 77 F.3d at 1287-88; *Concrete Machinery Co.*, 843 F.2d at 608-09. It is not a matter for submission to the jury.

The record fails to show a separability analysis of the type contemplated by the law in other circuits. In its absence, there was no proper determination that the mannequins at issue were copyrightable. Moreover, the reliance of the court below on mere "argument" and "belief", Pet.App. 25a; 74 F.3d at 494, rather than searching analysis, shows a marked departure from the practice of other circuits in the application of the Copyright Act.

II. The Circuits Have Decisively Split on the Issue of Copyrightability.

In applying the same law to the same or similar articles, the courts in this case, in *Hart*, and in *Country Kids* reach three different conclusions on copyrightability.

Country Kids involved wooded dolls modeled after traditional paper dolls. 77 F.3d at 1282. The court affirmed the district court's holding that the medium, size and shape of the dolls are not copyrightable features:

> [N]ot only is the idea of a wooden doll not copyrightable, but any basic and utilitarian aspects of the dolls, such as the shape of a human body and standard paper doll poses which are both friendly and inviting and also utilitarian for their ease of manufacture and adaptability to the attachment of various wardrobes, cannot be copyrighted.

Id. at 1287. The taxidermy mannequins here are not

copyrightable under the analysis in *Country Kids*. The shape of the mannequin is dictated by the shape of the body of the animal and by adaptability to mounting skins. In contrast, the court in *Hart* rejected the argument that utilitarian features made taxidermy mannequins non-copyrightable.

Petitioner initially argued here that the decision in *Carol Barnhart* was authority for the proposition that taxidermy mannequins are useful articles and hence not copyrightable. In the *Hart* decision, the court confronted the identical argument and squarely held that taxidermy mannequins are copyrightable despite their utilitarian features. --- F.3d at ---, 1996 WL 346330 at *4. This ruling disposed of the argument that the Second Circuit would hold that mannequins were non-copyrightable useful articles. But in so holding, partly on the authority of the opinion below, the *Hart* court created another conflict.

The court below concluded that ordinary taxidermy mannequins are not copyrightable. Pet.App. 21a-22a; 74 F.3d at 493. The one analysis of separability that the court below did conduct led it to conclude that ordinary mannequins lack the requisite originality of expression. *Id.* The court held that, as to such mannequins, the idea and expression are identical and inseparable. *Id.* The mannequins in this case were only copyrightable because they were created by sculpting rather than the usual process of casting directly from animal carcasses. *Id.* In effect, this ruling allowed the question of copyrightability to turn on a non-copyrightable element. The Copyright Act protects neither the idea, nor any procedure, process, system, method of operation, or concept, regardless of the form in which it is embodied in the work. 17 U.S.C. § 102(b). *See also Country Kids*, 77 F.3d at 1285.

That two Circuit Court of Appeals would reach opposite conclusions in applying the same law to the same article, indeed, to the same party, evidences a dramatic divergence in the understanding and consistent application of federal law. Merchants like the Petitioners operate on a national scale. The notion that they operate under a uniform federal law of copyright threatens to become a fiction.

CONCLUSION

The argument of Respondents that there is no split between the circuits in the application of the Copyright Act cannot be maintained in the face of the recent decisions *Hart* and *Country Kids*. This case provides the Court the means to take up these issues and clarify the correct application of the law. Otherwise, the law of copyright will continue to develop inconsistently. Contrary to its purpose of providing a consistent national rule, the Copyright Act will become an uncertain and capricious guide to those seeking to conform their conduct to the law.

WHEREFORE, the Petitioners respectfully request that the petition for writ of certiorari be granted.

Respectfully submitted,

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No. 95-1765

Supreme Court, U.S.
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In The

Supreme Court of the United States

October Term, 1995

DAN CHASE TAXIDERMY SUPPLY CO., INC., *et al.*,

Petitioners,

vs.

SUPERIOR FORM BUILDERS, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

SUPPLEMENTAL BRIEF FOR RESPONDENT

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INTRODUCTION

This supplemental brief is submitted pursuant to Rule 15.8 and Rule 25.5 of the Rules of the Supreme Court. Recently, the Second Circuit issued an opinion in *Forest Hart, et al. v. Dan Chase Taxidermy Supply Co., Inc.*, Docket No. 95-7603 (2nd Cir. 1996) (App. A, 1a-9a). This decision supports the Fourth Circuit's holding that the mannequins involved in this case are not useful articles and are copyrightable. Moreover, the Second Circuit specifically refutes Dan Chase Taxidermy Supply Co., Inc.'s ("Chase") argument that the Second Circuit's earlier decision in *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2nd Cir. 1985) creates a conflict between the Second Circuit and the Fourth Circuit.

ARGUMENT

I.

THE SECOND CIRCUIT'S RECENT OPINION SUPPORTS THE DISTRICT COURT'S AND APPEALS COURT'S HOLDING THAT THE TAXIDERMY MANNEQUINS WERE NOT USEFUL ARTICLES.

In *Forest Hart, et al. v. Dan Chase Taxidermy Supply Co., Inc.*, Docket No. 957603 (2nd Cir. 1996) (App. 1a-9a), the appellate court was faced with the issue of whether or not fish mannequins were "useful articles" and therefore not copyrightable. In that case, a group of taxidermists and taxidermy supply companies sued Dan Chase Taxidermy Supply Co., Inc. — the same defendant in the case at hand — for copyright infringement of taxidermy animal mannequins and fish mannequins. The District Court ruled that the taxidermy animal mannequins were not useful articles and thereby copyrightable. The fish mannequins, which did not have the

same decree of design as the animal mannequins, however, were ruled to be useful articles. 884 F. Supp. 71, 76-77 (N.D.N.Y. 1995)[1]. On appeal, the Second Circuit Court of Appeals cited with approval the Fourth Circuit's decision in *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co., Inc.* and stated that the function of the fish form was to portray its own appearance and "that fact is enough to bring it within the scope of the Copyright Act." (App. 9a).

Although the Second Circuit's analysis dealt with the fish forms, it employed the same reasoning used by the trial court and appeals court in the case at hand. The function of the fish forms — like the function of the animal forms — is to portray their own appearance.

II.

THE SECOND CIRCUIT'S RECENT DECISION CONFIRMS THAT THERE IS NO SPLIT AMONG THE CIRCUITS IN THE INTERPRETATION AND APPLICABILITY OF THE COPYRIGHT ACT.

Dan Chase Taxidermy Supply Co., Inc. ("Chase") argues that the Fourth Circuit decision below rejects the reasoning of the Second Circuit in *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2nd Cir. 1985). Accordingly, Chase argues that a split exists among the Circuits which requires review by this Court.

As argued in its Brief in Opposition, Superior Form Builders, Inc. ("Superior") maintains that the *Barnhart* case is

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1. The parties settled as to all other animals, and no trial ensued. Despite the settlement, the issue of the copyrightability of the fish mannequins remained on appeal.

distinguishable from the present case, and, in fact, no conflict exists. Adopting almost verbatim the same arguments that Superior makes in its brief, the Second Circuit held that its decision in *Barnhart* did not mandate a finding that the fish mannequins were useful articles.

> . . . Dan Chase argues that the fish mannequins serve the same purpose as the torsos did in *Barnhart* — they act as a mount for skin or clothing. In both cases, Chase says, the "display" function dictates the shape of the mannequin.
>
> We do not agree that *Barnhart* mandates a finding that fish mannequins are "useful articles" undeserving of copyright protection. First, in *Barnhart*, we had no occasion to question the party's stipulation that the human torsos were "useful articles." But even apart from the stipulation, we do not believe the *Barnhart* torsos can be analogized to the fish in this case. In *Barnhart*, the headless, armless, backless, styrene torsos were little more than glorified coat-racks used to display clothing in stores. The torsos were designed to present the clothing, not their own forms. In taxidermy, by contrast, people look for more than a fish skin; they wish to see a complete "fish." (App. 8a).

The Second Circuit, then, has rejected one of Chase's arguments for this Court granting Chase's Petition for Writ of Certiorari. It has affirmly stated that its decision in *Barnhart* does not dictate a finding that contrary to the Fourth Circuit's

holding. Accordingly, no conflict exists which warrants this Court's review.

CONCLUSION

For the reasons set forth in Respondent's Brief in Opposition, and for the reasons set forth in this Supplemental Brief, the Respondent respectfully submits that the Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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APPENDIX A — OPINION IN *HART, ET AL. V. DAN CHASE TAXIDERMY SUPPLY* DATED JUNE 26, 1996

No. 1077 August Term, 1995

(Argued: March 21, 1996 Decided: June 26, 1996)

Docket No. 95-7603

FOREST HART, Sculptor, THOMAS RAY, d/b/a Hartforms; RESEARCH MANNIKINS; JOSEPH M. KISH, f/k/a Rocky Mountain Forms; FOSTER TAXIDERMY SUPPLY; MARTIN INDUSTRIES; SCR CORPORATION D/B/A/ JONAS SUPPLY CO.; PRECISION MANNIKINS, INC.; JOE COOMBS CLASSICS, INC.,

Plaintiffs,

ARCHIE PHILLIPS; JIM ALLRED TAXIDERMY SUPPLY; MATT THOMPSON TAXIDERMY AND SUPPLY, INC.,

Plaintiffs-Appellants,

v.

DAN CHASE TAXIDERMY SUPPLY COMPANY, INC.,

Defendant-Appellee.

Before: FEINBERG, MAHONEY, and CALABRESI, *Circuit Judges.*

Appeal from a summary judgment of the United States District Court for the Northern District of New York (Frederick J.

Scullin, Jr., *Judge*), holding that various fish mannequins are not copyrightable because they possess no artistic features not commanded by the concept of a realistic fish; that, in other words, there are so few ways of expressing the idea of a fish mannequin that the idea and its expression effectively "merge." 884 F. Supp. 71 (N.D.N.Y. 1995). We believe, however, that the district court should not have considered the applicability of the merger doctrine until it heard evidence of "substantial similarity" between the parties' works.

Vacated and remanded.

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Syracuse, N.Y., *for Plaintiff's-Appellants.*

LAWRENCE TRAPANI (Bernhard P. Molldrem, James J. Guiliano), Trapani & Molldrem, Syracuse, N.Y., *for Defendant-Appellee.*

CALABRESI, *Circuit Judge*:

In *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 418-19 (2d Cir. 1985), we held that mannequins of human torsos were not copyrightable sculptural works. The parties before us today dispute whether the Copyright Act protects not human forms, but rather forms designed to hold up fish skins. This case therefore presents a modest question: Is taxidermy different? [1] We hold that it is.

The parties also dispute whether the district court acted prematurely in considering, as part of its copyrightability

inquiry, whether there are so few ways of expressing the idea of a fish mannequin that the idea and its expression effectively "merge." We hold that it did consider the merger doctrine too early, and therefore vacate and remand for further proceedings.

I. BACKGROUND

The plaintiffs are designers of taxidermy mannequins, which are used to mount animal skins. The plaintiffs registered their creations with the United States Copyright Office, and claim that the defendant, Dan Chase Taxidermy Supply Co. ("Dan Chase"), is infringing their copyrights by selling exact duplicates of their products.

After an evidentiary hearing, the district court concluded that almost all of the animal mannequins at issue (bear, moose, sheep, deer, steer, and antelope) had enough artistic detail to be copyrightable. 884 F. Supp. 71, 77 (N.D.N.Y. 1995). The only exceptions were fish mannequins. The fish, the court found, had "no meaningful detail . . . that is not commanded by the idea of a realistic fish." 884 F. Supp. at 76. Accordingly, it held that the fish "exemplif[ied] the merger of idea and expression" and were not copyrightable. *Id.* The court dismissed the plaintiffs' claims with regard to the fish and directed that the case proceed to trial to determine whether the other animal mannequins had, in fact, been copied by Dan Chase.

The parties settled as to all the other animals, and no trial ensued. Because of the settlement, only the fish-carving plaintiffs remain to appeal, and they contest the district court's ruling that their fish mannequins were not copyrightable.

II. DISCUSSION

Since the plaintiffs registered their fish mannequins with the U.S. Copyright Office, their works enjoy a presumption of protection, 17 U.S.C. [[section]] 410(c), and Dan Chase bears the burden of proving that the registered copyrights are invalid, *Barnhart*, 773 F.2d at 414.

The Copyright Act covers "[p]ictorial, graphic, and sculptural works" which include "three-dimensional works of fine, graphic, and applied art, . . . diagrams, [and] models . . . includ[ing] works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned." 17 U.S.C. [[section]] 101. The Act does not, however, protect "useful articles" — that is, articles "having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." *Id.* A useful article will "be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id.*

Mannequins straddle the line between utilitarian and sculptural works, and so one is tempted to describe them as "useful sculptures." On the one hand, the district court accepted testimony that each sculptor's "intent and purpose in creating the animal mannequins at issue was to make lifelike forms and to capture his or her individual perception of the animals." 884 F. Supp. at 74. Such testimony supports the view that the mannequins are artistic expressions that qualify as protectable "sculptural works." Yet the products indisputably serve a very practical purpose: They act as a mount for animal skins. *Id.* This

characteristic suggests that they may be no more than "useful articles," and, as such, not copyrightable. In fact, however, many objects are both useful and works of artistic craftsmanship. Even useful articles, moreover, can gain copyright protection for any "physically or conceptually separable" artistic features. *Barnhart*, 773 F.2d at 418.

The district court in this case, however, did not decide whether the fish mannequins were useful articles, and if they were, whether they nevertheless had any "physically or conceptually separable" artistic features that were copyrightable. (It merely noted that "most" of the animal forms in dispute were not useful articles, 884 F. Supp. at 74, and that "many" of the forms also had conceptually separable artistic separable parts, the fish mannequins . . . are not copyrightable" because "there are [so] few ways in which to express the idea of a realistic fish body in a mannequin [that] the expression merges with the idea." *Id.* at 77.

A. *Merger of Idea and Expression*

We have explained the merger doctrine in the following way:

The fundamental copyright principle that only the expression of an idea and not the idea itself is protectable has produced a corollary maxim that even expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself.

Kregos v. Associated Press, 937 F.2d 700, 705 (2d Cir. 1991) (citation omitted); *see* 17 U.S.C. [[section]] 102(b) ("In no case does copyright protection . . . extend to any idea . . . ."). But,

having recognized that the concept of merger differs from the question of infringement, we nevertheless indicated our strong preference for considering, in the context of the infringement inquiry rather than in that of copyrightability, the issue of whether an idea inevitably "merges" with its expression. *Kregos*, 937 F.2d at 705. A court will normally have a "more detailed and realistic basis" for evaluating the identity between idea and expression if it has all the contested forms of expression before it. *Id.* For in essence, the merger inquiry asks whether *all* realistic fish mannequins, no matter how artistic they might be, will necessarily be "substantially similar." And only if this is so, is there no unique expression to protect under the copyright laws. *See Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 916 (2d Cir. 1980); *Reyher v. Children's Television Workship*, 533 F.2d 87, 91 (2d Cir.) (" '[S]imilarity of expression . . . which necessarily results from the fact that the common idea is only capable of expression in more or less stereotyped form will preclude a finding of actionable similarity.' ") (quoting 1 NIMMER ON COPYRIGHT [[section]] 143.11 (1975 ed.)), *cert. denied*, 429 U.S 980 (1976).

We hold that the district court invoked the merger doctrine prematurely. It is true that *Kregos* did not categorically forbid district courts from reaching merger questions before hearing evidence about substantial similarity. There may be highly unusual cases in which virtually all of an idea's possible expressions are before a district court at the copyrightability stage. In such rare cases it may perhaps be possible to determine the merger issue while deciding whether a given expression is copyrightable. But we agree with *Kregos* that this is very unlikely and therefore adhere to our strong preference that the question be decided only after all the evidence of substantial similarity is before the court.

In the current case, eight of the plaintiff's fish mannequins were admitted into the record as exhibits and are before us. *See* 884 F. Supp. at 73, 76 (determining copyrightability based upon eight of the plaintiffs' fish, selected by stipulation of the parties). But we have not seen the defendants' mannequins. And at the moment, we cannot say that all realistic fish are necessarily so similar to each other that to copyright any of them would be tantamount to copyrighting an idea rather than an artistic manifestation.

More important, we do not know how the district court could comfortably reach that conclusion at this stage of the proceedings. Certainly, the court was able to compare the eight fish forms that were before it, some of which were by different craftsmen. But had the court considered the defendants' purported copies alongside the plaintiffs' original fish mannequins, it would have had a somewhat broader evidentiary basis for determining whether the universe of possible fish mannequins is so narrow as to preclude copyright protection. It could for instance, compare and contrast purported copies and admitted originals by different carvers. After seeing all such additional evidence, the court may very well adhere to its view that all realistic fish mannequins must look the same. But such a sweeping conclusion would then be more reliably grounded and there would exist a more "detailed and realistic basis," *Kregos*, 937 F.2d at 705, for determining whether the particulars of all fish mannequins are dictated by the very notion of a lifelike fish.

Because we believe that the district court's determination should be made only after hearing evidence about substantial similarity, we vacate the judgment and remand for that hearing.

B. *Useful Articles*

Dan Chase urges us to affirm anyway, arguing that fish mannequins are "useful articles" and hence are not entitled to copyright protection regardless or merger. It relies primarily on our decision in *Barnhart*, in which we found that styrene human torsos used to display blouses and sweaters were not copyrightable. In that case, the parties had stipulated that the torsos were "useful articles," 773 F.2d at 414, that were designed "to display clothes," *id.* at 418. Taking this concession as our starting point, we concluded that the torsos did not possess separable aesthetic or artistic features, and that nothing about them was therefore copyrightable. Dan Chase argues that the fish mannequins serve the same purpose as the torsos did in *Barnhart* — they act as a mount for skin or clothing. In both cases, Dan Chase says, the "display" function dictates the shape of the mannequin.

We do not agree that *Barnhart* mandates a finding that fish mannequins are "useful articles" undeserving of copyright protection. First, in *Barnhart*, we had no occasion to question the parties' stipulation that the human torsos were "useful articles." But, even apart from the stipulation, we do not believe that the *Barnhart* torsos can be analogized to the fish in this case. In *Barnhart*, the headless, armless, backless styrene torsos were little more than glorified coat-racks used to display clothing in stores. The torsos were designed to present the clothing, not their own forms. In taxidermy, by contrast, people look for more than a fish skin; they wish to see a complete "fish." The superficial characteristics of the fish, such as its color and texture, are admittedly conveyed by the skin, but the shape, volume, and movement of the animal are depicted by the underlying mannequin. Whether the fish is shown as resting, jumping,

wiggling its tail, or preparing to munch on some plankton, is dictated by the mannequin and by its particular form, not by the skin. 884 F. Supp. at 74 (crediting expert testimony that "a taxidermist buys a mannequin which expresses the pose, attitude and appearance of the animal that will satisfy his or her customer").

In short, the fish mannequin is designed to be looked at. That the fish mannequin is meant to be viewed clothed by a fish skin, rather than naked and on its own, makes no difference. The function of the fish form is to portray its own appearance, and that fact is enough to bring it within the scope of the Copyright Act. 17 U.S.C. [[section]] 101; *accord Superior Form Builders v. Dan Chase Taxidermy Supply Co.*, 74 F.2d 488 (4th Cir. 1996) (distinguishing *Barnhart* and holding that mammal taxidermy mannequins are "sculptural works" rather than "useful articles" because their utilitarian aspects serve merely to portray the appearance" of the animal), *pet. for cert. filed*, 64 U.S.L.W. 3765 (Apr. 29, 1996).

We conclude that fish mannequins, even if considered "useful articles," are useful insofar as they "portray the[ir] appearance." 17 U.S.C. [[section]] 101. That makes them copyrightable.

III. CONCLUSION

The district court may be right: If you've seen one fish mannequin, you've seen them all. But it may also be wrong. In the end, a determination can only be properly made after all the evidence of "substantial similarity" has been heard.

Accordingly, we vacate the judgment and remand the case.